

1-1-1992

A Rose by Any Other Name: Trademark Protection of the Names of Popular Music Groups

Barbara Singer

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Recommended Citation

Barbara Singer, *A Rose by Any Other Name: Trademark Protection of the Names of Popular Music Groups*, 14 HASTINGS COMM. & ENT. L.J. 331 (1992).

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A Rose by Any Other Name: Trademark Protection of the Names of Popular Music Groups

by
BARBARA SINGER*

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Introduction

While Shakespeare may have questioned the worth of a name,¹ today's popular music groups are only too conscious of the value attached to their professional monikers. The typical popular group knows that its fans associate its sound with its name. And with that association, the group's name becomes capable of selling live performances and recordings rendered by the group, commercial tie-ins, and even unrelated consumer goods.²

However, the ever-growing benefits that now stem from a popular music group's name do bring at least one reciprocal negative economic effect: the more valuable the name, the more likely it is to be subject to infringing uses that can actually devalue the name. Such uses, whether in good or bad faith, may be made by individuals or entities that have had no prior connection to the group. Infringement claims may also arise when one or more of the band's members depart from the group, or when the band splits from its manager or its label.³

As both the number and the economic impact of infringement claims rise, more and more of these claims are being played out in the

1. In the famous balcony scene of *Romeo and Juliet*, Juliet cries, "What's in a name? that which we call a rose, By any other name would smell as sweet." WILLIAM SHAKESPEARE, *ROMEO AND JULIET*, act 2, sc. 2.

2. The selling power that has attached to The New Kids on the Block's name is a recent example of the latter phenomenon. According to *FORBES*, this "teenybop" quintet topped the list of highest-paid entertainers for 1991. P.N., *It's Slippery at the Top*, *FORBES*, Sept. 30, 1991, at 113. The New Kids earned an estimated \$115 million in 1990 and 1991, which in 1990 included \$75 million in ticket sales and \$1 billion in merchandising items such as tee shirts, lunch buckets, and toys. *Id.*

Corporate sponsorship of world tours has also become the vogue. During the past few years, fruitful sponsorship agreements have been struck between the Rolling Stones and Anheuser-Busch/Budweiser, Paul McCartney and Visa, Paul Simon and American Express, Clint Black and Miller Lite, and The Who and Schlitz. *Budweiser Announces Sponsorship of the Rolling Stones "Steel Wheels" U.S. Tour*, PR NEWswire, Aug. 22, 1989; Steve Hochman, *McCartney Masters the Possibilities: Inks Deal with Visa*, L.A. TIMES, Nov. 28, 1989, at F4; *Paul Simon Launches World Tour in Tacoma*, PR NEWswire, Jan. 8, 1991; *Miller Lite to Sponsor Concert Tour of Country Music Star Clint Black*, BUSINESS WIRE, May 17, 1991; Leo Sacks, *Is Rock Going Madison Avenue? Well, the Whodunit*, TIME, Dec. 6, 1982, at 48.

The Who's expected take for that tour was \$30 million, while the Stones were guaranteed \$65-70 million for the tour plus a pay-per-view television special. Robert Hilburn, *Never Too Old to Rock*, L.A. TIMES, Jun. 25, 1989, at 59. Together, The Who, Rolling Stones, and Paul McCartney concerts described above were expected to generate \$250-300 million in box office, merchandising, and closed-circuit television receipts. *Id.*

3. As one court recently explained:

Imagine, for example, a group which lawfully acquires the "Beatles" trademark and performs without one or more of John, Paul, George or Ringo or "Jimmy Dorsey's Orchestra" without Jimmy Dorsey. Could the corporate owner of the "Rolling Stones" mark replace the present members of the group and continue to sell out Madison Square Garden? In short, can the public consciousness of and secondary meaning acquired by a performing group's trade name survive personnel changes?

courts. However, some courts have openly declared their discomfort upon being asked to resolve such cases. Some courts have displayed their unease by openly admitting their unfamiliarity with popular music forms.⁴ Others have expressly lamented the great difficulty they perceive in attempting to determine who is legally entitled to use an artistic entity's name, particularly where the competing factions were all once contributing members of that entity.⁵ Whatever the cause of this judicial

Rare Earth, Inc. v. Hoorelbeke, 401 F. Supp. 26, 37 n.19 (S.D.N.Y. 1975).

The Beatles did, of course, initially play without Ringo (the original line-up featured Pete Best on drums). *THE ROLLING STONE ILLUSTRATED HISTORY OF ROCK & ROLL* 177-89 (Jim Miller ed. 2d ed. 1980) [hereinafter *ROLLING STONE*] and *THE HARMONY ILLUSTRATED ENCYCLOPEDIA OF ROCK* 14-15 (Mike Clifford, consultant, 6th ed. 1988) [hereinafter *HARMONY*].

Furthermore, the Rolling Stones have continued to prosper despite certain changes in their band membership. Mick Jagger, Keith Richards, Charlie Watts, Bill Wyman, and Brian Jones formed the original Rolling Stones in 1963. Jones died in 1969 and was replaced by Mick Taylor. Taylor left in 1974 and was replaced by Ron Wood. *ROLLING STONE, supra* at 195-200 and *HARMONY, supra* at 146-47.

Other veteran rock bands, such as The Who and The Allman Brothers Band, have also continued to play under their original names even after the loss of key members. See *ROLLING STONE, supra* at 292, 357-58 and *HARMONY, supra* at 9-10, 188-89.

Some bands have not, however, continued to perform after the loss of a key member. For example, Robert Plant, Jimmy Page, and John Paul Jones disbanded Led Zeppelin after the 1980 death of John Bonham. *HARMONY, supra* at 98-99.

In the end, as will be discussed *infra*, the answer to the question of whether a band's name can survive personnel changes depends on a complicated mix of the band's desires, the public's whims, and principles of trademark and contract law.

4. See, e.g., *Pump, Inc., v. Collins Management, Inc.*, 746 F. Supp. 1159 (D. Mass. 1990). The presiding judge attempted to deal with his ignorance by adopting a writing style that teeters between tongue-in-cheek and sarcastic. In a footnote that sought to explain the success of Aerosmith, a veteran heavy metal group, the court offered the following description of the band's music:

As most persons interested in rock music are aware, Aerosmith has developed a well-earned reputation as one of America's louder rock bands and has cultivated a devoted adolescent following since the early 1970s. Its hit songs include such classics as "Walk This Way," "Dream On," "Sweet Emotion," "My Big Ten Inch," and the poignant "Dude Look Like a Lady." The Court expresses no opinion as to the socially redeeming aspects of Aerosmith's work.

Id. at 1161 n.2.

Despite its unease with the subject matter, the *Pump* court did attempt to make a careful analysis of the relevant legal issues. See *infra* text accompanying notes 191-96, 215-19, 225-26, 230-32, 242-43, and 250-62. In making that analysis, however, the court's unfamiliarity with popular music did cause it to err in judging the important issue of consumer sophistication. See *infra* note 239.

5. Indeed, the difficulties surrounding the ownership and use of a group name were noted as early as 1897 in *Messer v. "The Fadettes"*, 46 N.E. 407 (Mass. 1897). In a concluding sentence that conjures up the fears expressed 78 years later by the *Rare Earth* court, the dissent in *Messer* wondered, "Could it be held that members of the orchestra who chose to leave could associate themselves together and perform under this name without being liable to be restrained by injunction?" *Id.* at 408. See also *Rare Earth, Inc. v. Hoorelbeke*, 401 F. Supp. 26, 37 n.19 (S.D.N.Y. 1975).

reluctance,⁶ the rapidly increasing economic opportunities that derive from a group's name dictate that the courts rise above their fears and provide clear answers to the legal issues presented to them.

This article attempts to set forth criteria to assist the courts as they are increasingly forced to grapple with the issues of trademark ownership and infringement of popular music group names. In doing so, the article first briefly explores the trademark and contractual methods available for establishing ownership of a group name. Next, the article examines the manner in which an infringement is determined under the principles of trademark law both in the absence and the presence of contractual allocations. Following this examination, the article explores the use of injunctive relief to remedy infringements. The article concludes by summarizing the criteria that courts should consider in awarding ownership and prohibiting infringement of the names of popular music groups.

I

Establishing Ownership of Trademarks in the Names of Popular Music Groups

A. Ownership as Determined Under the Principles of Federal Trademark Law

Regardless of how it originally chose its name,⁷ a successful popular music group invariably reaps substantial financial gains from the use of that name.⁸ A group's name is thus a valuable asset, the ownership of which the group often goes to great lengths to protect.

6. Such reluctance may also be caused in part by the fact that trademark litigation concerning popular music group names has also in some cases been inordinately protracted. The bloody history of The Platters, for example, is spread out over a number of cases and jurisdictions. See, e.g., *Robi v. Five Platters, Inc.*, 918 F.2d 1439 (9th Cir. 1990); *Robi v. Five Platters, Inc.*, 838 F.2d 318 (9th Cir. 1988); *Five Platters, Inc. v. Cook*, 491 F. Supp. 1165 (W.D. Pa. 1980); *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372 (D. Md. 1976); *Williams v. Five Platters, Inc.*, 181 U.S.P.Q. (BNA) 409 (Pat. Off. Trade. Tr. & App. Bd. 1974), *aff'd*, 510 F.2d 963 (C.C.P.A. 1975). See also Jeff Hardy, *Pretenders Plague Platters*, UPI, May 16, 1986. Robi's suit alone dragged on for sixteen years and was not finally decided until after his death. *Platters' Award Upheld*, UPI, Nov. 14, 1990. Furthermore, at one point, California and New York courts reached opposite results on one particular issue of the case. See *Robi v. Five Platters, Inc.*, 918 F.2d 1439 (9th Cir. 1990); *Robi v. Five Platters, Inc.*, 838 F.2d 318 (9th Cir. 1988). The litigation even included a suit against Skipper's seafood restaurant chain. UPI, Mar. 15, 1986.

See also *In re Grand Funk Railroad Trademark Litig.*, 371 F. Supp. 1084 (1974). The members of Grand Funk Railroad split from their manager, Terry Knight, in the early 1970s. After this split, the band continued to play under the Grand Funk name. Knight, as a minority shareholder in the band's corporation, soon filed 29 trademark infringement actions against the band. *Id.* at 1084.

7. See *infra* 36-56 for examples of some notable choices.

8. See *supra* text accompanying note 2.

The Lanham Act⁹ is one of the most important vehicles currently available for the protection of the names of popular musical groups.¹⁰ Section 43(a) of that Act¹¹ prohibits the false designation of the origins of goods or services in commerce.¹² The essence of any claim brought under this section is an allegation that the consuming public has been deceived about the origin of a product.¹³ In order to succeed on such a claim, a plaintiff must first show that he is the owner of a valid trade or service mark.¹⁴

9. 15 U.S.C. §§ 1051 - 1128 (1988).

10. The right of publicity and the right of privacy may also provide valuable protection for group names. The right of publicity protects against the unauthorized commercial use of a name. See, e.g., Richard B. Hoffman, *The Right of Publicity—Heirs' Right, Advertisers' Windfall, or Courts' Nightmare?* 31 DEPAUL L. REV. 1 (1981). The right of privacy protects against an unwanted invasion of solitude. See, e.g., William L. Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960).

11. The text of this section provides that:

Any person who, on or in connection with any goods or services . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(1) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . .

....
shall be liable to a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a) (1988).

12. The provisions of the Lanham Act apply only to cases involving interstate or foreign commerce. 15 U.S.C. § 1051 (1988). See also *Park 'n Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985); *CBS Inc. v. Springboard Int'l Records*, 429 F. Supp. 563, 566 (S.D.N.Y. 1976).

In today's electronic age, most successful popular music groups provide goods or services that cross state lines. The activities of these groups are therefore almost invariably subject to Lanham Act jurisdiction.

However, the goods and services provided by popular music groups are also subject to regulation under state laws of unfair competition. See, e.g., *Pump, Inc. v. Collins Management, Inc.* 746 F. Supp. 1159, 1171-73 (D. Mass. 1990); *Grondin v. Rossington*, 690 F. Supp. 200, 205-07 (S.D.N.Y. 1988); *Rick v. Buchansky*, 609 F. Supp. 1522, 1545 (S.D.N.Y.), *appeal dismissed*, 770 F.2d 157 (2d Cir. 1985). The principles of state trademark law are virtually identical to those of the Lanham Act. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1361 (D.N.J. 1981). Because of that close resemblance, this article will focus solely upon the federal law of trade and service marks.

13. *Kingsmen v. K-Tel Int'l, Ltd.*, 557 F. Supp. 178, 181 (S.D.N.Y. 1983).

14. The Lanham Act also provides protection for trade names. The Act defines "trade name" as "any name used by a person to identify his or her business or vocation." 15 U.S.C. § 1127 (1988).

1. *Validity of the Mark*

a. Popular Music Group Names as Marks

Trademarks and service marks are "similar yet distinct creatures."¹⁵ A trademark distinguishes the goods of one party from those of another.¹⁶ Compact discs, phonorecords, audio tapes, and video tapes are all goods to which a trademark may be attached.¹⁷ A service mark, on the other hand, distinguishes the services of one party from those of another.¹⁸ Musical entertainment clearly qualifies as a service that can be represented by mark.¹⁹

Despite the differences between these two types of marks, both serve the same twin purposes. First, they inform the public of the source of

15. *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22, 23 n.1 (1st Cir. 1989). See also *Pump, Inc.*, 746 F. Supp. at 1165.

16. The Lanham Act defines "trademark" as:

any word, name, symbol, or device, or any combination thereof

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

15 U.S.C. § 1127 (1988). See also *Pump, Inc.* 746 F. Supp. at 1165; *Boston Athletic Ass'n*, 867 F.2d at 23 n.1.

17. See, e.g., *In re Polar Music Int'l AB*, 714 F.2d 1567, 1569 n.1 (Fed. Cir. 1983), where the Swedish vocal group ABBA successfully registered its name as a trademark for its sound recordings, including phonograph records, pre-recorded tapes, cartridges, disks, and other phonorecords.

18. The Lanham Act defines "service mark" as:

any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if the source is unknown.

15 U.S.C. § 1127 (1988).

19. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1362-64 (D.N.J. 1981) (Elvis Presley); *Marshak v. Green*, 505 F. Supp. 1054, 1057-58 (S.D.N.Y. 1981) (The Drifters); *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372, 381 (D. Md. 1976) (The Platters). Cf. *In re Carson*, 197 U.S.P.Q. (BNA) 554, 554-56 (Pat. & Trade. Off. Trade. Tr. & App. Bd. 1977) (entertainment services of comedian Johnny Carson qualified for protection under his service mark).

goods or services.²⁰ Second, they assure the public of the quality of those goods or services.²¹

Standing alone, the name of a popular music group may not be entitled to mark status. *In re Leader Publications, Ltd.*,²² involved a vocal group called the Troubadors, which sought to register its name as a trademark.²³ The court determined that the group's name did not identify records or tapes but rather served merely to identify the group of artists whose performances were captured on those recordings.²⁴ Trade-mark registration was therefore denied.

However, a group's name may serve as a trade or service mark when it identifies the source of goods or services. The federal registration application of the Swedish group ABBA²⁵ was considered in *In re Polar Music International AB*.²⁶ The name ABBA on the group's albums was determined to indicate not just a source of the performances embodied in the albums but also the source of the records and tapes and the sounds recorded on them.²⁷ Furthermore, the name had been used a number of times on different albums and therefore had come to represent an assurance of quality to the consuming public.²⁸ Because the group's name

20. See *Polar Music Int'l*, 714 F.2d at 1571. However, the mark need not be the name of the manufacturer of the goods or services, and the public need not know the name of the owner. *Id.*

In identifying the source of the goods, the mark serves both to permit the owner to control the reputation of his product and to protect the public from likelihood of confusion. *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976), *rev'd and remanded on other grounds*, 572 F.2d 574 (7th Cir. 1978). See also *Estate of Presley*, 513 F. Supp. at 1362.

21. Furthermore, section 43(a) of the Lanham Act protects both trade and service marks. See *supra* note 11 for the text of section 43(a). Therefore, many Lanham Act cases do not even bother to distinguish between the two types of marks. See, e.g., *Pump, Inc. v. Collins Management, Inc.*, 746 F. Supp. 1159, 1165 (D. Mass. 1990).

22. 135 U.S.P.Q. (BNA) 375 (Pat. Off. Trade. Tr. & App. Bd. 1962).

23. Registration was sought under the provisions of the Lanham Act. *Id.* at 376.

24. 135 U.S.P.Q. at 376; accord *Polar Music Int'l*, 714 F.2d at 1572. Note also that a performance itself cannot be a service mark. *Estate of Presley*, 513 F. Supp. at 1363 n. 31.

25. Agnetha Faltskog, Bjorn Ulvaeus, Benny Andersson, and Anni-Frid Lyngstad-Fredriksson formed ABBA in 1971. The group's name was taken from the first letter of the first name of each of the group's members. Their hits include "Fernando" and "Dancing Queen." HARMONY, *supra* note 3, at 8.

26. 714 F.2d 1567 (Fed. Cir. 1983).

27. *Id.* at 1572. According to the court, "[t]he quality of a sound recording encompasses both the quality of the sounds themselves and the quality of the material on which the sounds are recorded." *Id.*

28. *Id.* The court emphasized that the public commonly requests records and tapes by the name of the recording artist. *Id.*

functioned as and served the purposes of a trademark, it could thus be registered as such.²⁹

b. Distinctiveness of a Group's Name as a Mark

In order to qualify as a trade or service mark, the name of a popular music group must therefore identify the goods or services produced by the group. However, the band seeking to establish mark status for its name must also demonstrate the distinctiveness of its mark before such status will be granted.³⁰ Distinctiveness is important because it shows the tendency of the mark to identify the goods or services provided under the mark as emanating from a particular source.³¹

The relative distinctiveness of a mark has traditionally been determined by categorizing the mark as arbitrary or fanciful, suggestive, descriptive, or generic.³² An arbitrary³³ or fanciful³⁴ term has no connection with the type of good or service produced. Oftentimes, a popular music group intentionally chooses a name that bears no relationship to the goods and services provided by the group.³⁵ The group name "The Drifters," for example, has been labeled arbitrary because it amounts to the use of a common word in an unfamiliar context (singing).³⁶ And surely off-beat names such as "The Traveling Wilburys,"³⁷

29. *Id.* In support of its conclusion, the court noted that in 1978 the Statler Brothers vocal group had been permitted to register its name as a mark for the group's phonorecords. *Id.* at 1571 n.2.

See also *In re Carson*, 197 U.S.P.Q. (BNA) 554, 555 (Pat. & Trade. Off. Trade. Tr. & App. Bd. 1977). In that case, comedian Johnny Carson was permitted to register his name as a service mark because he used the name not only to identify himself but also to identify entertainment services rendered by him in commerce.

30. *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1131 (2d Cir. 1979). "Strength" is the word that has traditionally been used to describe both the ease with which a mark's validity may be established and the degree of protection that the mark will be afforded. *Id.* However, both the Lanham Act and the First Restatement of Torts speak in terms of distinctiveness. See 15 U.S.C. § 1052(f) (1988); RESTATEMENT (FIRST) OF TORTS § 731(f) cmt. e (1938). (The drafters of the Second Restatement of Torts decided not to include sections on unfair competition, on the ground that it had become an independent body of law. See RESTATEMENT (SECOND) OF TORTS, Introductory Note to Division Nine, *Interference with Advantageous Economic Relations* (1977).) As a result, many courts now use "distinctiveness" in place of "strength." See, e.g., *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1364 (D.N.J. 1981).

31. *McCaregor-Deniger*, 599 F.2d at 1131.

32. *Id.*

33. An arbitrary term is an ordinary word that does not suggest or describe the product in question. *Union Nat'l Bank v. Union Nat'l Bank*, 909 F.2d 839, 845 (5th Cir. 1990). For example, the word "Ivory" is arbitrary when applied to soap. *Id.*

34. A fanciful term is a coined word, such as Xerox or Kodak. *Id.*

35. See *infra* 36-56 for a discussion of how musical groups select their names.

36. *Marshak v. Sheppard*, 666 F. Supp. 590, 600 (S.D.N.Y. 1987). However, an early press release suggested that the name did have a connection with the members of the group: apparently "the members had done a lot of drifting from one group to another." ROLLING

"The Doors,"³⁸ "Three Dog Night,"³⁹ and "INXS"⁴⁰ should be classified as arbitrary or fanciful.

STONE, *supra* note 3, at 16. Indeed, over 50 performers sang with the group during its three-decade history. HARMONY, *supra* note 3, at 49. Thus, the name may actually have been suggestive or perhaps even descriptive.

The name "The Platters" has likewise been found to be arbitrary. *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372, 381 (D. Md. 1976). According to the court in that case, "The Platters" is "a strong 'mark' in that as the name of a singing and entertainment group it is arbitrary and distinctive, bereft of any descriptive meaning." *Id.* The court did, however, note that "platter" is a generic term when applied to dishes. *Id.* at 381 n.6. See also *Three Degrees Enter., Inc. v. Three Degrees Worldwide, Inc.*, No. 89-5131, 1989 U.S. Dist. LEXIS 12016, at *13 (E.D. Pa. Oct. 12, 1989) (group name "The Three Degrees" is a fanciful term), *aff'd*, 902 F.2d 1562 (3d Cir. 1990), *motion clarified*, No. 89-5131, 1990 U.S. Dist. LEXIS 108077 (E.D. Pa. Aug. 17, 1990), *order vacated in part*, 944 F.2d 898 (3d Cir. 1991) [hereinafter *Three Degrees*]; *Anderson v. Capitol Records, Inc.*, 178 U.S.P.Q. (BNA) 238, 241 (Cal. Super. Ct. 1973) (band name "Flash" is arbitrary because it is not descriptive or suggestive of the type or nature of services provided).

37. This super-group was formed by George Harrison, Bob Dylan, Tom Petty, Jeff Lynne, and the late Roy Orbison. The name was apparently suggested by Britain's Prince Charles at a Prince's Trust concert. The name comes complete with a whimsical family history dating back to the sixth century. The five mythical Wilburys are Nelson (Harrison), who is the group's official biographer, Lucky (Dylan), Otis (Lynne), Charlie T. Jr. (Petty), and Lefty (Orbison). These half-brothers each have a different mother but were all sired by Charles Truscott Wilbury Sr., a notorious drinker and womanizer. Stephen Holden, *The Pop Life*, N.Y. TIMES, Nov. 16, 1988, at C22. According to the liner notes that accompanied the Wilburys' first album, the original Wilburys "were a stationary people who, realizing that their civilization could not stand still forever, began to go for short walks." Stephen Williams, *Five Star Traveling Music by the Wilburys*, NEWSDAY, Nov. 6, 1988, part II, at 21 (quoting TRAVELLING WILBURYS VOLUME ONE (1988)). During these walks, some were exposed to "wives, roadies and drummers," causing them to go astray and to become "hairdressers or TV rental persons." *Id.*

The name may also have a further hidden meaning: "Wilbury" is alleged boys'-club slang for a musical or a recording mistake. John Rockwell, *Recordings: Old Timers Out for a Spin Cut a Couple of Disks*, N.Y. TIMES, Nov. 13, 1988, Section 2, at 27. The Wilburys' hits have included "Handle With Care," "End of the Line," and "Heading for the Light."

38. The legendary Doors were formed in 1965 by Jim Morrison, Ray Manzarek, Robby Krieger, and John Densmore. HARMONY, *supra* note 3, at 47-48. Morrison borrowed the group's name from the writings of William Blake. Most attribute the source to the Blake passage that reads, "[i]f the doors of perception were cleansed/All things would appear infinite." *Id.* at 48. Others point to the Blake passage that reads, "There are things that are known and things that are unknown, in between are the doors." Pat H. Broeske, *Morrison's Mystique*, L.A. TIMES, Jan. 7, 1990, at 7. The Doors' classics include "Light My Fire," "Break On Through," and "L.A. Woman."

39. Three Dog Night was formed in 1968 by Danny Hutton, Cory Wells, Chuck Negron, Joe Schermie, Floyd Sneed, Jim Greenspoon, and Mike Allsop. HARMONY, *supra* note 3, at 173. The band, which featured Hutton, Wells, and Negron on lead vocals, borrowed its name from Eskimo lore. According to legend, the colder the night, the more dogs that are brought in to sleep with a person. A "three dog night" is the coldest possible night. *Id.* The group's hits included "One," "Eli's Coming," and "Joy to the World."

40. "INXS" is pronounced "in excess." This six-member Australian band features Andrew, Jon, and Tim Fariss, Kirk Pengilly, Garry Gary Beers, and Michael Hutchence. The band was purportedly named by its recording company. According to guitarist Fariss, the label suggested "In Excess." "But without a record out, it seemed people came to shows if

A suggestive term subtly "suggests" the nature of the product.⁴¹ A consumer is thus required to draw upon his imagination in order to determine the nature of the product.⁴² Names such as "The Beatles"⁴³ and "The Moody Blues,"⁴⁴ which hint at the band's style, and "The Hol-

your name was really big on your posters. We wanted ours huge, so we shortened it." Steve Dougherty, *Adulation is the "New Sensation" as Aussie Heartthrob Michael Hutchence Still Leads His Band In, Well, INXS*, PEOPLE, July 11, 1988, at 108. See also HARMONY, *supra* note 3, at 80. INXS has recorded hits such as "New Sensation" and "What You Need."

41. See *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372 (D. Md. 1976). Although the court in that case found the name "The Platters" to be an arbitrary mark, the court nevertheless noted that "platter" is used colloquially by radio announcers to describe phonorecords. *Id.* at 381 n.6. Hence, when used, as here, to describe a recording group, the name might be considered by some to be suggestive. *Id.*

On occasion, the line between arbitrary and suggestive may indeed be difficult to draw. In choosing to call themselves The Who, Roger Daltrey, Pete Townshend, John Entwistle, and Keith Moon hinted that they did not wish to suggest anything by their choice of a group name. As the liner notes from *THE WHO SINGS MY GENERATION* (1966) explain "Why The Who? There is no definition of their sound, just as there is no description of their character. The name does not suggest any specific image of the group, which is their intent. Hence, why *not* The Who?"

42. *Union Nat'l Bank v. Union Nat'l Bank*, 909 F.2d 839, 845 (5th Cir. 1990).

43. The band was originally called the "Quarrymen," after John Lennon's school, Quarry Bank, and a nearby quarry where Lennon and his friends were wont to congregate. SOLT & EGAN, *IMAGINE: JOHN LENNON* 25 (1988). The name later became "Johnny and the Moon-dogs." *Id.* at 27. Allegedly at the suggestion of original member Stu Sutcliffe, the name was then changed to the "Silver Beetles," in tribute to Buddy Holly and the Crickets. Richard Harrington, *The Day the Music Lived: Buddy Holly and The Birth of Rock*, WASH. POST, Feb. 5, 1984, at H1. See also SOLT & EGAN, *supra*, at 27; HARMONY, *supra* note 3, at 14. Lennon later suggested dropping the "Silver" and changing the "ee" in Beetles to "ea" to emphasize the group's beat. Harrington, *supra*.

44. This group was formed in 1964 by Mike Pinder, Denny Laine, Ray Thomas, Clint Warwick, and Graeme Edge. HARMONY, *supra* note 3, at 52, 117. They originally called themselves the M & B Five, in an unsuccessful attempt to secure financial backing from Mitchell & Butler, a local Birmingham brewery. *THE MOODY BLUES: LEGEND OF A BAND* (Polygram Video); Dennis Polkow, *Their Days of Future Haven't Passed: The Moody Blues Refuse to Become a Rock History Lesson*, CHI. TRIB., Aug. 5, 1991, Tempo, at 1. When the pitch failed, the group fitted the words "Moody Blues" to the "M & B" letters to conjure up the band's rhythm and blues flavor. *Id.* See also ROLLING STONE, *supra* note 3, at 347.

Laine and Warwick left in 1966 and were replaced by Justin Hayward and John Lodge. HARMONY, *supra* note 3, at 52, 117. With the latter line-up, the group recorded hits such as "Tuesday Afternoon," "Nights in White Satin," and "I'm Just a Singer (In a Rock and Roll Band)." After a four-year hiatus during the middle seventies, the band regrouped in 1978, with Patrick Moraz in place of Pinder. *THE MOODY BLUES: LEGEND OF A BAND*, *supra*.

lies"⁴⁵ and "Pink Floyd,"⁴⁶ which hint at the band's musical roots, should qualify as suggestive names.⁴⁷

A descriptive term actually describes a characteristic or quality of the product in question.⁴⁸ A group name such as "Crosby, Stills & Nash" (and sometimes Young),⁴⁹ "Santana,"⁵⁰ or "Fleetwood Mac,"⁵¹

45. This band, which was formed in 1962, originally featured Graham Nash, Allen Clark, Tony Hicks, Eric Haydock, and Don Rathbone. *HARMONY*, *supra* note 3, at 76. Like the Beatles, the band chose its name as a tribute to the legendary Buddy Holly. *ROLLING STONE*, *supra* note 3, at 81. Its best-known recordings include "Bus Stop," "Look Through Any Window," and "Carrie-Anne."

46. The band's name was chosen as a tribute to two legendary Georgia bluesmen, Pink Anderson and Floyd Council. *HARMONY*, *supra* note 3, at 130. The group, which was formed in 1966, originally featured Roger Waters, Syd Barrett, Richard Wright, and Nick Mason. After Barrett was replaced by David Gilmour, the band recorded classics such as "Another Brick in the Wall, Part 2," "Money," and "Us and Them."

Waters split from the band in 1983 and sued his former colleagues in 1987 to prevent them from using the band's name in the future. However, Waters lost this suit. Steve Hochman, *Celebrating the Downfall of the Berlin Wall: Concert: Former Pink Floyd Leader Roger Waters Will Take His Epic "The Wall" to the Source . . . East Berlin*, L.A. TIMES, Jun. 14, 1990, at F1; Richard Harrington, *Renaissance at the Lincoln Theatre*, WASH. POST, Nov. 29, 1989, at B7.

47. The Canadian band Payola\$ made an imaginative but unfortunate choice of a name. Because this name suggested the bribery scandals that rocked the music industry during the 1950s and 1960s, the group lost bookings and was forced to change its name to Rock and Hyde. Ruth Atherley, *Seeking Pop's Promised Land*, MACLEAN'S, July 6, 1987, at 36. For a history of the payola scandal, see *ROLLING STONE*, *supra* note 3, at 101-03.

48. *Union Nat'l Bank v. Union Nat'l Bank*, 909 F.2d 839, 845 (5th Cir. 1990). According to the First Restatement of Torts, a descriptive term describes ingredients, quality, properties, or uses. RESTATEMENT (FIRST) OF TORTS § 721 (1938). See also *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981). The court found Elvis Presley's name (both first and surname) to be a non-inherently distinctive mark. *Id.* at 1364. In traditional terms, "non-inherently distinctive" would correspond with "descriptive."

49. In 1968, David Crosby (formerly of The Byrds), Stephen Stills (formerly of Buffalo Springfield), and Graham Nash (formerly of The Hollies) formed their own super group. *ROLLING STONE*, *supra* note 3, at 404. See also *HARMONY*, *supra* note 3, at 37. The trio recorded classics such as "Marakesh Express" and "Suite: Judy Blue Eyes." In 1970, Crosby, Stills and Nash were joined by Neil Young. *Id.* This quartet went on to record hits such as "Woodstock" and "Our House."

50. Santana debuted in 1969, featuring Carlos Santana, Mike Carabello, Jose "Chepito" Areas, Gregg Rolie, David Brown, and Mike Shrieve. *HARMONY*, *supra* note 3, at 151-52. The band's hits have included "Oye Como Va," "Black Magic Woman," and "Evil Ways."

51. The first incarnation of Fleetwood Mac, which appeared in 1967, featured Mick Fleetwood, John McVie, Peter Green, and Jeremy Spenser. *HARMONY*, *supra* note 3, at 60-61. The band achieved its greatest success after the line-up changed to include Fleetwood, McVie, Christine McVie, Stevie Nicks, and Lindsey Buckingham. *Id.* at 61. With the latter membership, the group recorded hits such as "Rhiannon," "Go Your Own Way," and "You Make Loving Fun."

Even this band has had name problems: during the band's early years, it was forced to sue its former manager, who had launched a band of unknown performers under the name "Fleetwood Mac." Katrine Ames, *Hey, Mac!* NEWSWEEK, May 10, 1976, at 121.

which describes some or all of the members of the group,⁵² might well be classified as descriptive.⁵³ Similarly, a name such as "Boston"⁵⁴ or "Chicago,"⁵⁵ which indicates the band's city of origin, should also fall into the descriptive category.⁵⁶

52. The Lanham Act does not permit the registration of a mark that is primarily a surname. 15 U.S.C. § 1052(e) (1988). However, a surname may be registered if it "has become distinctive of the applicant's goods in commerce." *Id.* at § 1052(f). See also *Dolby v. Robertson*, 654 F. Supp. 815, 821 (N.D. Cal. 1986).

53. See RESTATEMENT (FIRST) OF TORTS § 722 (1938) concerning the use of personal names as trade or service marks.

54. Boston was founded in 1975 by Tom Scholz, an MIT-educated engineer for Polaroid. Michael A. Lerner, *Boston's Slam-Dunk*, NEWSWEEK, Dec. 1, 1986, at 91. See also HARMONY, *supra* note 3, at 21. The band, which has recorded hits such as "More Than a Feeling" and "Don't Look Back," is perhaps best known for its painstaking recording methods: Scholz took six years to record the group's first album, Janet Maslin, *Scholz's Last Tape*, NEWSWEEK, Nov. 15, 1976, at 116, two to record the second (which Scholz claims was "hurried"), and eight to record the third. Gary Graff, "Third Stage" Rockets Boston Back to Success City, CHI. TRIB., July 27, 1987, at C3.

Inter-band squabbles have recently led to litigation. See *Masdea v. Scholz*, 742 F. Supp. 713 (D. Mass. 1990).

55. Chicago debuted in 1969 as Chicago Transit Authority. This veteran band initially showcased jazz-flavored music that was heavily spiced with horns. ROLLING STONE, *supra* note 3, at 353. Original members included Robert Lamm, Terry Kath, Walter Parazaidar, James Pankow, Lee Loughnane, Daniel Seraphine, and Peter Cetera. James William Guercio joined the group for its second album. *Id.* Kath died in 1978 and Cetera left in 1985. Lynn Van Matre, *Life After Chicago: It's Hard for Peter Cetera to Say He's Sorry*, CHI. TRIB., Oct. 5, 1986, Arts, at 8. The band's many hits include "25 or 6 to 4," "Does Anybody Really Know What Time It Is?," and "Make Me Smile."

56. See *Union Nat'l Bank v. Union Nat'l Bank*, 909 F.2d 839, 845 (5th Cir. 1990); *Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 319 F.2d 273, 276 (C.C.P.A. 1963). The Lanham Act confirms that a name that is primarily geographical is classified as descriptive. 15 U.S.C. § 1052(e) (1988). As with a surname, a geographic name is not entitled to registration under the Lanham Act unless it has become distinctive. *Id.* § 1052(f).

In the end, the line between a descriptive and a suggestive term is not always easy to draw. See *Union Nat'l Bank*, 909 F.2d at 846-47. The First Restatement of Torts stated that the test is imaginativeness: a descriptive term is close, direct, and generally useful in approximately that form to all merchants, while a suggestive term is remote, subtle, and not needed by other merchants. RESTATEMENT (FIRST) OF TORTS § 721 cmt. a (1938). A name such as "The Fat Boys" does describe the physical size of members of the group, but it bears little connection to their style of music. For a case involving an allegation of trademark brought by the Fat Boys, see *Tin Pan Apple, Inc. v. Miller Brewing Co.*, 737 F. Supp. 826 (S.D.N.Y. 1990).

"Guns N' Roses" is a band name that also teeters between descriptive and suggestive. The name describes several original members of the band (ex-member Tracii Guns and the mercurial Axl Rose, respectively). Jonathan Gold, *Guns N' Posers: L.A. Hard Rock Evolves; How Guns N' Roses' Success Surprised, then Shaped the Sounds of Sunset Strip*, L.A. TIMES, Oct. 15, 1989, at 67. However, the name also evokes other rock bands to which current members previously belonged (L.A. Guns, Hollywood Rose, and Rose). Jeff Spurrier, *Guns & Roses: Bad Boys Give it Their Best Shot*, L.A. TIMES, Jul. 6, 1986, at 74.

As discussed *infra*, the difference between a suggestive and a descriptive mark may be crucial in determining ownership under trademark law.

A generic term simply refers to a genus or class of products, to which an item in question merely belongs.⁵⁷ Since the typical band seeks a name that separates it from its competitors, a group name is unlikely to fall into the generic category.⁵⁸

c. Secondary Meaning

Both arbitrary or fanciful and suggestive terms are considered to be inherently distinctive.⁵⁹ Thus, they are entitled to protection upon adoption and use.⁶⁰ A descriptive term, however, is considered to be non-distinctive or weak.⁶¹ Because a descriptive term lacks sufficient strength, it is denied protection unless or until it becomes distinctive or, in traditional terms, acquires a "secondary meaning."⁶² Secondary meaning thus serves to lift a non-distinctive mark out of "the ordinary language of the public domain."⁶³

57. *Union Nat'l Bank*, 909 F.2d at 845. Cf. *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372, 382 (D. Md. 1976). A generic or common term is not entitled to trademark protection. *Park 'n' Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985). Indeed, a mark can be canceled upon a showing that it has become generic. 15 U.S.C. § 1064(3) (1988).

58. However, query the result if a court had been called upon to classify the moniker of the legendary rock group The Band. The Band, which consisted of Garth Hudson, Rick Danko, Richard Manuel, Levon Helm, and Jamie "Robbie" Robertson, first gained public attention during the mid-1960s as Bob Dylan's back-up band. However, the group's greatest fame came in the late 1960s, after it began to perform and play on its own. *ROLLING STONE*, *supra* note 3, at 309-15. The Band's hits include "Rag Mama Rag," "Up On Cripple Creek," and "The Night They Drove Old Dixie Down."

59. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1364 (D.N.J. 1981). For examples of marks that have been held to be distinctive, see, e.g., *Bell v. StreetWise Records, Ltd.*, 640 F. Supp. 575, 579 (D. Mass. 1986) ("The New Edition" was conceded to be distinctive); and *Rick v. Buchansky*, 609 F. Supp. 1522, 1530 (S.D.N.Y.), *appeal dismissed*, 770 F.2d 157 (2d Cir. 1985) ("Vito and the Salutations" was held to be facially distinctive).

60. *Estate of Presley*, 515 F. Supp. at 1364. However, even a distinctive mark can lose its strength and thus its protection if it becomes generic. A mark may become generic if it comes to signify to the consuming public no more than a nature or class of goods or services. *Five Platters*, 419 F. Supp. at 382.

61. 15 U.S.C. § 1052(e) (1988).

62. *Miss Universe, Inc. v. Patricelli*, 408 F.2d 506, 509 (2d Cir. 1969). A showing of secondary meaning is not required for arbitrary or fanciful or suggestive marks. However, some courts nevertheless have been quick to point out the secondary meaning that has attached to distinctive marks, perhaps in part to underscore the strength of such marks for the purpose of determining likelihood of confusion. See, e.g., *Rick*, 609 F. Supp. at 1530 ("Vito and the Salutations" was conceded to have acquired a secondary meaning over the 23 years of its use); *Five Platters*, 419 F. Supp. at 381 ("The Platters" qualified as an arbitrary mark and had developed a secondary meaning); *Anderson et al. v. Capitol Records, Inc.*, 178 U.S.P.Q. (BNA) 238, 241 (Cal. App. Dep't Super. Ct. 1973) ("Flash" was arbitrary and the name had acquired a secondary meaning in the San Francisco Bay Area).

63. *Cinepix, Inc. v. Triple F Prods.*, 150 U.S.P.Q. (BNA) 134 (N.Y. Spec. Term 1966).

A mark⁶⁴ may acquire a secondary meaning if and when the consuming public recognizes the mark as both an identification of goods or services and a symbol indicating that the goods or services emanate from a single source.⁶⁵ According to the court in *Five Platters, Inc. v. Purdie*,⁶⁶ the group name "The Platters"⁶⁷ clearly fulfilled the requirements for acquiring a secondary meaning. According to that court, such a meaning was acquired through the widespread circulation of the group's successful records, the group's many public performances, and the promotional efforts of the group's managers.⁶⁸ "The Platters" thus came to signify to the consuming public the particular vocal group that performed under that name.⁶⁹

Similarly, in *Estate of Presley v. Russen*,⁷⁰ the court was asked to determine the validity of Elvis Presley's name as a service mark.⁷¹ After determining that both Presley's first and surnames were non-inherently distinctive marks, the court searched for secondary meaning in those names. Such meaning was easily found, since Presley's name had been used over a long period of time in various promotional arenas.⁷² Thus,

64. "Trade dress" may also acquire a secondary meaning. *Cesare v. Work*, 520 N.E.2d 586, 592 (Ohio Ct. App. 1987). In *Cesare*, the plaintiff had conceived and organized a band called "Revolver," which performed an act that combined the minute detail of the Beatles' concert appearance with the superior sound produced by the Beatles in the recording studio. *Id.* at 590. In addition, while the Beatles' performances rarely included conversations, Revolver's act included scripted banter among band members and audience participation. *Id.*

According to the *Cesare* court, "trade dress" is a "constellation of characteristics" associated with a particular product. *Id.* at 595. The court found the trade dress in question to include the use of the name "Revolver" or "formerly of Revolver," endorsements and accolades, advertising packages and folders, and audience participation and band patter routines. *Id.* at 592.

The *Cesare* court then noted that trade dress may acquire a secondary meaning when the consuming public associates the trade dress with a particular producer. *Id.* at 592. Through its three years of use, the "constellation of characteristics" that constituted Revolver's trade dress had come to be associated uniquely with the plaintiff's band and had thereby acquired a secondary meaning. *Id.* at 595.

65. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1364 (D.N.J. 1981).

66. 419 F. Supp. 372 (D. Md. 1976).

67. The Platters were founded in Los Angeles in 1953 by Herb Reed, Paul Robi, David Lynch, and Tony Williams. Zola Taylor joined soon thereafter. During the 1950s, this group recorded classics such as "The Great Pretender" and "Smoke Gets in Your Eyes." *Platters' Award Upheld*, UPI, Nov. 14, 1990. See also HARMONY, *supra* note 3, at 131.

68. 419 F. Supp. at 381.

69. *Id.*

70. 513 F. Supp. 1339 (D.N.J. 1981).

71. The rival use in this case was carried on by Rob Russen in his production entitled "The Big El Show." *Id.* at 1348. This production was patterned after Presley's stage performances and featured a singer who impersonated Presley's singing and dress styles. *Id.*

72. These included, *inter alia*, in advertising, on records, and in connection with certain licensed products. *Id.* at 1364.

Presley's name had acquired a secondary meaning associated with his entertainment services as distinct from other entertainment services.⁷³

2. *Ownership of a Mark in a Popular Music Group Name*

Once the validity of a mark in a popular music group's name has been established, the plaintiff group must show that it is the owner of that mark.⁷⁴ Under traditional trademark law, a trade or service mark is considered to be a property right.⁷⁵ In *Rare Earth, Inc. v. Hoorelbeke*,⁷⁶ the court noted that the band name "Rare Earth" had grown in value as the band gained national exposure and derived increased revenues from

73. *Id.* See also *Rare Earth, Inc. v. Hoorelbeke*, 401 F. Supp. 26 (S.D.N.Y. 1975). The parties stipulated that the name "Rare Earth" was a valid mark that had acquired secondary meaning, "in that rock music aficionados associate the group with a particular style or variety of musical performance." *Id.* at 37 n.19; see also *Noone v. Banner Talent Associates, Inc.*, 398 F. Supp. 260, 262 (S.D.N.Y. 1975) (the group name "Herman's Hermits" had acquired a secondary meaning); *Anderson v. Capitol Records, Inc.*, 178 U.S.P.Q. (BNA) 238, 241 (Cal. App. Dep't Super. Ct. 1973) (the band name "Flash" had acquired a secondary meaning in the San Francisco Bay Area).

But see *Bell v. StreetWise Records, Ltd.*, 761 F.2d 67 (1st Cir. 1985), *appeal after remand*, 787 F.2d 578 (1st Cir. 1986). At the time the group New Edition assigned its name to music entrepreneur Maurice Starr's business, the name was known only in Boston lounges, clubs, and schools. Thus, at best the name had acquired a secondary meaning for live performances in the Boston area. However, the name had clearly failed to acquire a secondary meaning "in the phonorecord world either locally or nationally," since the group had not yet made any recordings at the time the assignment was executed. *Id.* at 71.

74. Principles of business entities law generally dictate that the group, rather than its individual members, should acquire ownership of the group's mark. A partnership arrangement was found in a case involving The Buckingham, a 1960s Chicago band known for its hit "Kind of a Drag." *Giammarese v. Delfino*, 197 U.S.P.Q. (BNA) 162, 163 (N.D. Ill. 1977). A similar finding of a partnership was found in the case of Buffalo Springfield. This respected sixties band featured, *inter alia*, Dewey Martin, Neil Young, and Stephen Stills, and recorded the classic "For What It's Worth." Irwin O. Spiegel, *Rights in Group Names*, 1 PERFORMING ARTS REV. 417, 417-18 (1970). In both of these cases, traditional partnership law was applied, vesting ownership of the band's name in the band as an entity. See also *Bailly v. Betti*, 148 N.E. 776 (N.Y. 1925) (goodwill of a partnership may include the partnership name); *Peterson v. Lightfoot*, 191 P. 48, 49 (Cal. N.Y. Ct. App. 1920) (partnership's name was deemed to be partnership property because its value stemmed from the joint efforts of the partners). See also Uniform Partnership Act section 8, which stipulates that property originally brought into the partnership or subsequently acquired on the partnership's account belongs to the partnership. UNIF. PARTNERSHIP ACT § 8, 6 U.L.A. 115 (1916).

Where a band functions as an unincorporated association, ownership is also normally vested in the group rather than in its individual members. *Boogie Kings v. Guillory*, 188 So. 2d 445, 449 (La. Ct. App.), *writ refused*, 191 So. 2d 140 (La. 1966). A like result may also follow from a finding of a joint venture. *Fuqua v. Watson*, 107 U.S.P.Q. (BNA) 251 (N.Y. Spec. Term 1955).

75. *Estate of Presley*, 513 F. Supp. at 1350.

76. 401 F. Supp. 26 (S.D.N.Y. 1975).

concerts and recordings.⁷⁷ As a result, the name had become a protectable property interest.⁷⁸

However, a mark is property only as an appurtenance to an established business in connection with which it is used.⁷⁹ Thus, in order to gain protection for a mark under § 43(a) of the Lanham Act, an owner must actually use the mark in commerce.⁸⁰ In *Capetola v. Orlando*,⁸¹ the court was asked to determine whether a young singer had initially acquired ownership of the mark "Dawn."⁸² Because the singer had assumed that name in 1960 and had continuously used⁸³ the name as a mark in interstate commerce for ten or eleven years, the court found that she had indeed acquired ownership of the mark.⁸⁴

a. Priority of Appropriation

Because Lanham Act claims generally involve conflicting uses of a mark, a showing of mere use generally does not suffice for the purpose of establishing ownership. Rather, the plaintiff must prove that he was the

77. *Id.* at 29.

78. *Id.* at 39. See also *Boogie Kings*, 188 So. 2d at 445. The band name "Boogie Kings" qualified as a property right because, through the popularity and reputation garnered by the band, the name had come to have significance and value. *Id.* at 448.

79. *Rockowitz Corset & Brassiere Corp. v. Madam X Co.*, 162 N.E. 76, 78-79 (N.Y. 1928), *reargument denied*, 162 N.E. 550 (N.Y. 1928). As such an appurtenance, the mark becomes an element of the business' good will. *E.F. Prichard Co. v. Consumers Brewing Co.*, 136 F.2d 512, 518-19 (6th Cir. 1943), *cert. denied*, 321 U.S. 763 (1944).

80. *Kingsmen v. K-Tel Int'l*, 557 F. Supp. 178, 181 (S.D.N.Y. 1983). Although certain advantages may flow from federal registration, use, rather than registration, is the basis for Lanham Act jurisdiction. *Rare Earth*, 401 F. Supp. at 37-38. Indeed, the Lanham Act clearly protects the names of popular recording groups even in the absence of federal registration. *Grondin v. Rossington*, 690 F. Supp. 200, 207-08 (S.D.N.Y. 1988).

Marks that have been used in commerce may, of course, be registered under the Lanham Act. 15 U.S.C. § 1051(a) (1988). The Trademark Revision Act of 1988 also makes provision for "intent-to-use" applications for registration. *Id.* § 1051(a). However, in order to avoid a finding of abandonment, an owner who has filed an intent-to-use application must file a proof of use affidavit within six months after the date upon which he receives notice of the initial allowance of his mark. *Id.* § 1051(d)(1).

In any event, federal registration simply provides *prima facie* evidence of the validity of the registered mark, ownership of the mark, and the owner's exclusive right to use the mark in commerce. *Id.* § 1057(b). In addition, five years' uncontested continuous use of the mark following registration entitles the registrant to claim that his right in the mark is incontestable. *Id.* § 1065. Incontestability status may serve as conclusive proof of the owner's right to use the mark. *Id.* § 1115(b). However, even a claim based on an incontestable mark is subject to a variety of defenses, including, *inter alia*, fraud in obtaining registration or incontestability status, abandonment, and misrepresentation that has been permitted by the owner. *Id.*

81. 463 F. Supp. 498 (E.D. Pa. 1978).

82. The young singer, Joan Capetola Robertson, had attempted to transfer the mark to a management corporation owned and operated by her parents.

83. She used the name both individually and as a member of a group. 463 F. Supp. at 499.

84. *Id.* at 499, 506.

first to use the mark in commerce.⁸⁵ In *Anderson v. Capitol Records, Inc.*,⁸⁶ two bands, one founded in San Francisco and the other in England, adopted the name "Flash." Ownership of the name was awarded to the group located in the San Francisco Bay Area, because that group's use preceded the English group's use by four years in California and approximately three and one-half years worldwide.⁸⁷

However, priority for the purposes of trademark ownership requires something more than nominal use. In *Bell v. StreetWise Records, Ltd.*,⁸⁸ the court was asked to determine whether the members of the New Edition⁸⁹ had established a usage of the group's name that preceded that of their manager/producer Maurice Starr.⁹⁰ In attempting to make that determination, the court carefully examined the factors that make usage "bona fide" for the purposes of trademark law. According to that court, usage must be deliberate and continuous, rather than sporadic, casual, or transitory.⁹¹ Furthermore, although a product need not be an instant success, its usage must be consistent with a present plan of commercial exploitation.⁹² The court then found that the first usage in commerce of

85. *Boogie Kings v. Guillory*, 188 So. 2d 445 (La. Ct. App. 3d Cir.), writ refused, 191 So. 2d 140 (La. 1966).

86. 178 U.S.P.Q. (BNA) 238 (Cal. Super. Ct. 1973).

87. 178 U.S.P.Q. at 241. See also *Three Degrees*, supra note 36 at *13, where the court maintained that the group's manager's "first and continuous use of the service mark The Three Degrees gives him a proprietary right in the mark."

However, see *Dolby v. Robertson*, 654 F. Supp. 815 (N.D. Cal. 1986). That case pitted Ray Dolby, inventor of the "Dolby Sound" process for noise reduction in audio recording, against popular singer Thomas Dolby (born Thomas Robertson). Ray Dolby was clearly the prior appropriator; nevertheless, he lost, due to the magnitude of the loss that the second user, Thomas Dolby, could suffer. *Id.* at 822-23. Some courts have, however, expressly disagreed with that approach. See *Anderson*, 178 U.S.P.Q. at 241.

Also note that at least some courts maintain that a junior user may prevail over a prior user if the junior is the first to acquire a secondary meaning in his name. *Cinepix, Inc. v. Triple F Prods.*, 150 U.S.P.Q. (BNA) 134 (N.Y. Spec. Term 1966). In addition, some courts have refused to enjoin the junior user if the junior used the mark in good faith and in a different market. See *Bell v. StreetWise Records, Ltd.*, 640 F. Supp. 575, 580 (D. Mass. 1986).

88. 640 F. Supp. 575 (D. Mass. 1986).

89. The members of the group were Ricardo Bell, Michael Bivins, Robert Brown, Ronald DeVoe, and Ralph Tresvant. *Id.* at 575. This "black bubblegum" group burst onto the national pop music scene in 1983 with the release of its recording of "Candy Girl." *Id.* at 578-79. The "bubble-gum" sound has been described as "the basic sound of rock and roll—minus the rage, fear, violence and anomie that runs from Johnny Burnette [who recorded "You're Sixteen"] to Sid Vicious [an infamous member of the Sex Pistols]." ROLLING STONE, supra note 3, at 328. "Bubble-gum" music tended to be played by studio or concept groups. *Id.*

90. Starr's real name is Larry Johnson. *Bell*, 640 F. Supp. at 576 n.1. Starr, whom the court described as "something of a local celebrity," has dabbled in many aspects of the recording business, including producing, engineering, and songwriting. *Id.* at 577-78 n.7. Indeed, Starr claims that he can play "every instrument there is." *Id.*

91. *Id.* at 580.

92. *Id.* The court also noted that the Lanham Act requires interstate usage. *Id.*

the name "New Edition" occurred in February 1983, when the single "Candy Girl" was released.⁹³ At the time of that release, the plaintiff musicians had been performing⁹⁴ and rehearsing regularly. Furthermore, they had been working with several individuals, including Starr, to further their careers and to secure a recording contract.⁹⁵ From these efforts, the court determined that the plaintiffs were operating under a "present plan of commercial exploitation."⁹⁶ The court therefore concluded that the plaintiffs had acquired legal rights to the "New Edition" mark through their prior use of it in intrastate commerce.⁹⁷

b. Control

Where priority of usage cannot be clearly established in a case of joint endeavor, ownership may be awarded to the party who controls or determines the nature and quality of the goods that have been distributed under the mark in question.⁹⁸ In *Bell v. StreetWise Records, Ltd.*,⁹⁹ the court considered control as an alternative method for determining who owned the "New Edition" name.¹⁰⁰ The question of control depends upon, first, the nature of the product in question and, second, the identity of the party who controls the quality of that product. In this case, the nature of the product was in dispute: the plaintiff singers claimed the subject was entertainment services, while the defendant producers claimed it was records.¹⁰¹ To ascertain the nature of the New Edition's product, the court therefore considered the contributions of both parties

93. The name had actually first been used in 1978 when Bell, Bivens, Brown, and two other singers formed a group. Their manager, Brook Payne, apparently coined the name. The group performed for only a few months before it disbanded. *Id.* at 577 n.5.

94. The group got its start in 1981 when it performed, under the name "New Edition," at a talent show at Boston's Roscoe Lounge. At that time, the members were each about thirteen years old. *Id.* at 577. By the time that "Candy Girl" was released, the group had already performed on at least 20 occasions in the local Boston area entertainment market. *Id.* at 580.

95. *Id.*

96. *Id.*

97. *Id.* See *Rick v. Buchansky*, 609 F. Supp. 1522 (S.D.N.Y.), *appeal dismissed*, 770 F.2d 157 (2d Cir. 1985), which presented conflicting evidence in regard to whether the manager of Vito and the Salutations or a member of the group had first used the group's name in commerce. Mere conception of a name without subsequent use in commerce is not sufficient to confer ownership. *Id.* at 1531. However, the *Rick* court was convinced that the question of who originally coined the name could have some bearing on the question of who first used it. *Id.* The fact that the manager had first coined the group's name ultimately helped to tip the priority balance in favor of the manager. *Id.* at 1538.

98. *In re Polar Music Int'l AB*, 714 F.2d 1567, 1571 (Fed. Cir. 1983).

99. 640 F. Supp. 575 (D. Mass. 1986).

100. *Id.* at 580. However, the court found as a preliminary matter that, absent a sale or assignment, the music business norm is for a group to own its name. *Id.* at 581.

101. *Id.* at 580. The reason for the conflict in these claims is clear: the plaintiffs as performers controlled the quality of their entertainment services, while Starr as producer controlled the quality of their records.

in manufacturing that product.¹⁰² Starr's contribution to the recording of "Candy Girl" was deemed to be substantial; however, this contribution was consistent with his duties as a record producer.¹⁰³ Furthermore, although StreetWise had extensively promoted the New Edition, the court found that marketing, or "educating your label," is a normal function of a record company.¹⁰⁴

The plaintiff musicians, on the other hand, had performed as the New Edition long before "Candy Girl" was released.¹⁰⁵ The New Edition also was not a "concept group";¹⁰⁶ rather, the members of the group

102. *Id.* at 581-82.

103. *Id.* at 581. Starr had composed that song and had played all of the instruments, had sung background vocals, and had done the arranging and mixing of that recording. *Id.* at 578. In addition, he apparently had to teach the then thirteen-year-old group members "everything." *Id.* In the court's words, "it is clear Starr ran the show in the sound studio." *Id.* The court stressed, however, that Starr had been credited with and compensated separately for each role he played. *Id.* at 581.

104. *Id.* at 580-81. This promotional campaign, which was launched after the release of the "Candy Girl" album, included print and radio advertisements and three music videos. *Id.* at 579. StreetWise also employed a clever, albeit unsuccessful, marketing tool to plug the release of the group's "Popcorn" single: the company sold movie theater popcorn boxes containing a cassette of the song and a New Edition tee-shirt. *Id.* at 579 n.11.

105. *Id.* at 580.

106. According to Thomas Silverman, an expert presented at trial by the defendants, a "concept group" is generally formed when an independent record company perceives "an unfilled 'niche' in the entertainment market." *Id.* at 581 n.18. To fill this gap, the company hires a group of musicians to promote the company's "concept" or marketing idea. *Id.* Under these circumstances, the record company owns the name of the group and controls the quality of the product. *Id.* Silverman cited "The Monkees" and "Menudo" as examples of concept groups. *Id.* A recent notorious example of a concept group is the dance music group called "Seduction." The music for the group's hit "Seduction" was recorded first by Robert Clivilles, a successful disc jockey, and David Cole, a songwriter, remixer, and record producer. When the song became popular, Clivilles and Cole took out an ad in the VILLAGE VOICE, looking for female singers to become the group Seduction. John Leland, *Seduction, '90s Style*, NEWSDAY, March 1, 1990, Part II at 4.

Despite the fact that the New Edition fit right into the "black bubblegum" niche that Starr had been trying to fill since 1972, the court did not find New Edition to be a concept group. Rather, the court maintained that "[t]hey may have walked straight into Starr's concept but, as he conceded at the hearing, they seem to have had the same idea he had." *Bell*, 640 F.Supp. at 581 n.18.

Studio groups constitute a related form of musical entertainment controlled by a producer or a label. Such a group generally consists of unknown performers, who have been assembled quickly and temporarily by a producer or a label for the sole purpose of recording a promising hit. See Charles P. Freund, *Ontological Rock: A Milli Vanilli Top 10*, WASH. POST, Nov. 18, 1990, at C2. Classic examples of studio groups include Edison Lighthouse, which recorded "Love Grows (Where My Rosemary Goes)" in 1970, White Plains, which recorded "My Baby Loves Lovin'" in 1970, The Pipkins, which recorded "Gimme Dat Ding" in 1970, and First Class, which recorded "Beach Baby" in 1974. All four of these studio groups were fronted by British singer Tony Burrows. *Id.*

Despite the light-weight image of concept and studio groups, at least one of them has actually been involved in litigation over the ownership of the group name. See *Gutkowski v. Jeckell*, N.Y. L.J., Nov. 26, 1968, at 16 col. 4, which concerned the name of a "bubblegum"

were known individually to the public. Furthermore, their public image was due to their personalities, not StreetWise's marketing techniques. Therefore, "[t]he 'magic' that sold New Edition, and which 'New Edition' has come to signify, is these five young men."¹⁰⁷ Once the court had identified the product in question as the distinct personalities and performance styles of the plaintiffs, the court found it easy to conclude that they had sole control over the quality of the entertainment services that they rendered. Ownership of the mark was therefore awarded to the members of the group.¹⁰⁸

Although Starr was not awarded ownership in *Bell*, managers, producers, and labels have been successful in proving ownership by control. *Rick v. Buchansky*¹⁰⁹ featured dueling "doo-wop"¹¹⁰ groups. In 1961, David Rick¹¹¹ discovered and signed four teen-aged Brooklyn street corner singers.¹¹² Under Rick's guidance, the group began to perform with modest success¹¹³ as Vito and the Salutations.¹¹⁴ Despite marked changes in the public's musical tastes¹¹⁵ and in the membership of Rick's

group called the "1910 Fruit Gum Company. The 1910 Fruit Gum Company's greatest claim to fame was "1,2,3, Red Light." The group was assembled by producers Jerry Kasenatz and Jeff Katz from the same pool of musicians that provided the musicians for another "bubblegum" group, The Ohio Express (which recorded "Yummy, Yummy, Yummy"). Robert K. Oermann, *Phony Pop Acts Part of Tradition*, GANNETT NEWS SERVICE, Nov. 23, 1990.

107. 640 F. Supp. at 582.

108. *Id.* Soon after they succeeded in proving that they owned the name "New Edition," the members of this group "informally" drifted apart. Jeffrey Kantrowitz, *New Edition in the Old Neighborhood; Fans—and Flak—Greet Group as it Films Video*, BOSTON GLOBE, Jun. 27, 1991, at 65. Since that time, Brown has gone solo, and Bell, Bivens, and DeVoe have been performing as the rap-pop trio Bell Biv DeVoe. *See id.* Starr has gone on to give the music world the New Kids on the Block. William R. Macklin, *Color Blind; White Rockers Make Inroads With Black Fans*, CHI. TRIB., Jun. 27, 1991, at 11C.

109. 609 F. Supp. 1522 (S.D.N.Y.), *appeal dismissed*, 770 F.2d 157 (2d Cir. 1985).

110. Norm N. Knight, a disk jockey for CBS-FM, a New York radio station, testified at trial as an expert on popular music. 609 F. Supp. at 1525 n.1. According to Knight, "doo-wop" music consists of "barbershop harmony with a beat." *Id.* *See also* ROLLING STONE, *supra* note 3, at 83-90.

111. Rick was already an established manager and promoter of "modestly successful" musical groups. *Rick*, 609 F. Supp. at 1526. Rick's other groups have included one of the many incarnations of The Drifters. *See* Marshak v. Green, 505 F. Supp. 1054, 1056 (S.D.N.Y. 1981).

112. *Rick*, 609 F. Supp. at 1526. The four original members of the group were Robert DiPaolo, Barry Solomon, Dominick Mitchell, and Vito Balsamo. *Id.*

113. The group's recording of "Gloria" became popular in New York, and its recording of "Unchained Melody" achieved nationwide success. *Id.*

114. Rick claimed to have coined the name, in an apparent nod toward noted "doo-wop" groups such as "Dion and the Belmonts" and "Jay and the Americans." *Id.*

115. The "British Invasion" of rock groups such as the Beatles and the Rolling Stones and the rise of the Motown sound of groups such as Smokey Robinson and the Miracles and The Temptations were cited as noted examples of those changes. *Id.* at 1526-27.

group,¹¹⁶ Rick managed to keep his group performing throughout the 1960s and 1970s.¹¹⁷ In 1980, however, certain former members of the group, including Vito Balsamo, the original "Vito,"¹¹⁸ formed a rival "doo-wop" group, also called "Vito and the Salutations."¹¹⁹ Rick then sued to enjoin the renegade group from using that name.¹²⁰

Over the years, Rick, as "employer," provided continuity in the group by overseeing the structure and the style of the group.¹²¹ In contrast, no one set of performers, including originals such as Balsamo, had stayed with the group long enough to assert any real control over the group's direction.¹²² The court therefore determined that Rick, rather than Balsamo, owned the "Vito and the Salutations"¹²³ mark."

c. Abandonment

Even where a *prima facie* case of ownership has been established, the owner of a popular music group's name may still be faced with the defense of abandonment,¹²⁴ which may be made upon a showing of discontinuance of use without intent to resume.¹²⁵ However, because a find-

116. DiPaolo, Mitchell, and Solomon all left the group within its first year. *Id.* at 1527. Balsamo came and went several times during the 1960s and 1970s and departed permanently in 1974. *Id.* All told, 22 different singers performed with the group during the 1960s and 1970s. *Id.*

117. *Id.*

118. Vito Balsamo, Sheldon Buchansky, Edward Pardocchi, James Spinelli, and Frankie Graziano were the ex-members who formed the rival group. *Id.* at 1528.

119. *Id.*

120. *Id.* By that time, Rick had managed to re-enlist original members DiPaolo and Barry Solomon. *Id.*

121. From 1961 on, Rick booked all of the group's performing engagements, arranged for its recording sessions, managed its financial affairs, paid for many of its expenses, and made key personnel decisions. *Id.* at 1532. Rick was thus the group's "longest-playing" member. *Id.* at 1528.

122. *Id.* at 1532.

123. *Id.* at 1546. *See also* *Cesare v. Work*, 520 N.E.2d 586, 595 (Ohio Ct. App. 1987) (The plaintiff as the creator, manager, and director of the band Revolver was entitled to claim protection for the band's trademark and trade dress.). When the artist consists of a "studio" or a "concept" group, the producer or label should also gain ownership through control.

124. Abandonment is an affirmative defense, for which the defendant bears the burden of proof. *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372, 382 (D. Md. 1976).

125. Section 45 of the Lanham Act provides:

A mark shall be deemed to be "abandoned" when either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be *prima facie* evidence of abandonment. "Use" of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a

ing of abandonment results in a forfeiture of a property interest, such a defense must be strictly proved.¹²⁶ Where the allegedly abandoned mark is the name of a musical group, that standard of proof is rarely met.

Three Degrees Enterprise, Inc. v. Three Degrees Worldwide, Inc.,¹²⁷ involved competing claims for the name "Three Degrees." This Philadelphia trio was originally formed in 1963 by its manager, Richard Barrett.¹²⁸ While performing in Bahrain in late December 1980, the then-current members of the group¹²⁹ fired Barrett, formed their own corporation,¹³⁰ and then continued to perform on a regular basis under the name "Three Degrees."¹³¹ Barrett for his part reorganized and rehearsed his group several times; they did not, however, perform in public for some eight years.¹³²

In 1989, Barrett finally brought suit to enjoin his former employees¹³³ from continuing to perform under the "Three Degrees" name. After determining that Barrett owned the "Three Degrees" mark,¹³⁴ the court considered the defendants' defense of abandonment. Under Section 45 of the Lanham Act,¹³⁵ two years of non-use is prima facie evidence of abandonment. Barrett's eight years of public non-use therefore raised a presumption of abandonment.

However, the presumption raised by Section 45 is rebuttable by evidence of the circumstances causing the non-use and a lack of intent to abandon.¹³⁶ The court found such evidence in the fact that Barrett had actively recruited for, rehearsed, and promoted his group from 1981 until the time of the instant suit. Furthermore, the Barrett group's failure to

mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.

15 U.S.C. § 1127 (1988).

Genericness is rarely in issue in cases involving the validity of musical group names. For an example of a case where the defense of genericness failed, see *Five Platters*, 419 F. Supp. at 382.

126. *Three Degrees*, *supra* note 36.

127. *Id.*

128. *Id.* The group's biggest hit was its 1974 recording of "When Will I See You Again?"

129. The three were Helen Scott, Valerie Holiday, and Sheila Fergusen. *Id.* According to the court, this group of singers was the "sixth configuration" of the trio. *Id.*

130. They called their corporation "Three Degrees Worldwide, Inc." *Id.* By written agreement, the members of the trio had originally been deemed employees of Three Degrees Enterprise, Inc., a corporation controlled by Barrett.

131. *Id.* From December 1980 until the time of the law suit, this group not only recorded but also toured Europe, Asia, and the Middle East.

132. *Id.*

133. By this time, Victoria Wallace had replaced Sheila Fergusen in the defendant group. *Id.*

134. *See supra* note 87.

135. 15 U.S.C. § 1127 (1988).

136. *Three Degrees*, *supra* note 36.

perform was directly related to the conduct of the defendant group. The court therefore held that Barrett had not abandoned the "Three Degrees" name.¹³⁷

Courts are hesitant to find abandonment even where a group has totally disbanded. *Kingsmen v. K-Tel International, Ltd.*,¹³⁸ concerned a "60s Dance Party" album that included a 1976 re-recording of the Kingsmen's¹³⁹ 1964 hit, "Louie, Louie."¹⁴⁰ The Kingsmen had admittedly disbanded and ceased performing and recording in 1967. However, even after it disbanded, the group continued to promote and to receive royalties for their previous recordings.¹⁴¹ The court found their receipt of royalties to negate any intent to abandon use of the "Kingsmen" name.¹⁴²

137. *Id.* See also *Cesare v. Work*, 520 N.E.2d 586, 594 (Ohio Ct. App. 1987). The plaintiff owner in that case had ceased to advertise for new band members approximately one year before he sued to enjoin ex-members from using the band's name or trade dress. The court stated that, in the absence of other evidence of intent to abandon, the passage of such a short time did not provide the necessary quantum of proof for abandonment. *Id.*

138. 557 F. Supp. 178 (S.D.N.Y. 1983).

139. The Kingsmen were formed in 1962 by a group of high school students, including Jack Ely, Lynn Easton, Michael Mitchell, Norman Sundholm, Richard Peterson, and Barry Curtis. *Id.* at 179. Their infamous recording of "Louie, Louie" assured their place in the history of rock and roll.

140. The re-recording was made by Ely, who had been the Kingsmen's lead singer at the time that the original recording of "Louie, Louie" had been made. *Id.* at 179-80. No other members of the Kingsmen participated in the re-recording. *Id.* at 180. The album that featured this re-recording bore the legends "Louie, Louie . . . The Kingsmen" and "[t]hese selections are re-recordings by the original artists." *Id.*

141. *Id.* at 183.

142. *Id.* As the court explained, "[t]hese plaintiffs have no more abandoned their right to protect the name of Kingsmen than have The Beatles, The Supremes or any other group that has disbanded and ceased performing and recording, but continues to collect royalties from the sale of previously recorded material." 213 U.S.P.Q. 991. See also *HEC Enters., Ltd. v. Deep Purple, Inc.*, 213 U.S.P.Q. (BNA) 991 (C.D. Cal. 1980). Deep Purple achieved substantial commercial success during the late 1960s and early 1970s with songs such as "Hush," "Smoke on the Water," and "Woman from Tokyo." In 1976, the group ceased presenting live performances in order to pursue the separate interests of the various group members. *Id.*

In 1980, original lead singer Rod Evans (who had left the band in 1971) and several other musicians began performing in the United States under the name "Deep Purple". When the management group and the corporation of the original Deep Purple group sued for trademark infringement, the Evans group claimed, *inter alia*, that the original group had abandoned the name when it disbanded in 1976. The court, however, found that the plaintiffs had not stopped using the name, nor did they intend to stop using it. To the contrary, since the disbanding, the plaintiffs had continued to release Deep Purple albums and had even received occasional invitations for live performances. *Id.* at 993.

Abandonment is almost impossible to find even where a group has been totally inactive for 30 years. During the late 1950s and early 1960s, a relatively unknown group of folk singers performed as the Highwaymen. For all intents and purposes, the group ceased to exist in 1962. In 1985, Willie Nelson, Waylon Jennings, Johnny Cash, and Kris Kristofferson recorded a song called "Highwaymen." Soon thereafter, this foursome of country music legends began to tour under that name. The original Highwaymen promptly sued to prevent the coun-

B. Contractual Allocations of Group Names

A popular music group may thus rely upon trademark law to determine who owns its name. However, many groups are not content to await the outcome of future litigation in order to know who presently has the right to own and to use their names. Rather, these bands now want, and indeed are encouraged by managers, labels, and attorneys alike,¹⁴³ to enter into express agreements concerning the ownership of their names.¹⁴⁴ Such an express agreement is likely to accompany the formalization of the group's structure. Such a formalization is, in turn, likely to be spurred by an increase in the group's drawing power, which may be manifested in increased bookings or a lucrative recording contract.

The formalization process is well-illustrated by the history of the rock group Rare Earth. During the late 1960s, this band organized and initially functioned as an informal group.¹⁴⁵ By July 1970, the band had gained a certain level of success, as measured by the national reputation that it had garnered and the substantial revenues that it had earned from concert bookings and record sales.¹⁴⁶ This success encouraged the band to incorporate. As part of this formalization, the corporation agreed to assume the assets, including the name, of the informal group.¹⁴⁷

try music group from continuing to use the name. The parties eventually reached a creative settlement to their differences: the country music group would continue to tour under the name, but the original folk group would serve as the opening act on at least one stop in that tour. David Margolick, *Law: At the Bar: The Highwaymen Come Singing, Singing and Much to the Chagrin of the Originals*, N.Y. TIMES, Aug. 3, 1990, at B7.

143. See, e.g., William Borchard, *Trademarks and the Arts*, 7 COLUM.-VLA J.L. & ARTS 1 (1982); Spiegel, *Rights in Group Names*, 1 PERFORMING ARTS REV. 417 (1976); and *The Four Aces Litigation: What's in a Name?* 5 ART & THE LAW 67 (1980).

144. An agreement concerning the ownership of a group name may also be implied. In *Boogie Kings v. Guillory*, 188 So. 2d 445 (La. Ct. App.), writ refused, 191 So. 2d 140 (1966), for example, the band's name was adopted by "mutual agreement" of the band members. From this informal agreement, the court inferred that members had intended the name to become vested in the association. *Id.* at 448-49.

An implied allocation of a group name may also arise from an employer-employee relationship. *Messer v. "The Fadettes"*, 46 N.E. 407 (Mass. 1897), involved a band of musicians called "Fadette Ladies Orchestra." Ethel Atwood had organized the band and had employed all of its musicians. From the employer-employee relationship, the court inferred that Atwood rather than the individual musicians owned the group's name. *Id.*

See also *Burrus Mill & Elevator Co. v. Wills*, 85 S.W.2d 851 (Tex. Civ. App. 1935), where the court similarly assumed that the name "Light Crust Doughboys" belonged to the employer mill rather than to the singers that the mill had formerly employed to advertise its products. *Cf. Three Degrees*, *supra* note 36.

145. *Rare Earth, Inc. v. Hoorelbeke*, 401 F. Supp. 26, 44 (S.D.N.Y. 1975). Peter Hoorelbeke, G. Bridges, Kenneth Folcik, Cox, and J. Persh constituted the original members of this band. *Id.* Edward Guzman joined the band in 1969. *Id.* The band recorded songs such as "Get Ready" and "(I Know) I'm Losing You."

146. *Id.* at 29.

147. *Id.* at 44. The corporation also assumed the liabilities of the informal group. *Id.* Soon after incorporation, Folcik, Cox, and Persh left the group. *Id.* at 29. By 1974,

The assignment of the name to the band's formal organization is often tied to contractual provisions concerning "leaving members."¹⁴⁸ These provisions contain the procedure to be followed when a member decides to leave the group.¹⁴⁹ As part of this process, each band member generally agrees that, should he leave the group, the name will remain the property of the group.¹⁵⁰

Hoorelbeke had also departed. *Id.* Following Hoorelbeke's departure, the remaining members of the group consisted of Bridges, Guzman, and two replacement performers, R. Monette and M. Olson. *Id.* Hoorelbeke then joined with Michael Urso to form a rival Rare Earth group. *Id.*

A similar story can be found in the history of the Southern rock band Lynyrd Skynyrd. This band was organized on an informal basis in the early 1970s. *Grondin v. Rossington*, 690 F. Supp. 200, 202 (S.D.N.Y. 1988). By 1974, the band had achieved some success and had managed to secure an exclusive recording contract with MCA Records, Inc. *Id.* In 1975, the band therefore decided to form Lynyrd Skynyrd Productions, Inc., which was designed to hold, *inter alia*, all rights to the band's trade name, trade marks, or service marks. *See also* *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372 (D. Md. 1976).

148. A "leaving member" is generally defined as anyone who ceases to be a member of the group, voluntarily or involuntarily. *See* COUNSELING CLIENTS IN THE ENTERTAINMENT INDUSTRY (1986) [hereinafter COUNSELING CLIENTS], which reproduces a record production agreement that defines a "leaving member" as any member who is terminated or who "cease[s] to be an actively performing member" of the group. *Id.* at 135. *See also* ENTERTAINMENT, PUBLISHING AND THE ARTS HANDBOOK 144-45 n.2 (1989) [hereinafter HANDBOOK].

149. These provisions define the rights and liabilities of a leaving member, such as his continued right to receive royalties. *See* COUNSELING CLIENTS, *supra* note 148, at 137. Where the leaving member provisions are contained in a management or a record production agreement, the contract generally provides the manager or the employer with the option to continue to employ the leaving member as a solo artist. *Id.* at 136-37. *See also* YOUR CLIENT'S FIRST RECORDING 1.12 (1989) [hereinafter FIRST RECORDING]; COUNSELING CLIENTS *supra* note 148, at 195. Provision also may be made for membership substitution that is triggered by notice of a leaving member. *See* *Larkin v. Polygram Records, Inc.*, No. 86 Civ. 1128 (RWS) (S.D.N.Y. May 23, 1986); *Gutkowski v. Jeckel*, N.Y. L.J., Nov. 26, 1968, at 16.

150. *See* the production agreement reproduced in COUNSELING CLIENTS *supra* note 148, at 135, in which the leaving member acknowledges that "the Group Name or any other name which we or any of us may now or hereafter utilize shall be and remain owned by . . . the remaining members of our group. . . ." *Id.*

Such an acknowledgement may also be phrased in terms of an assignment: the leaving members may agree that "they shall have relinquished and assigned whatever rights they may have had in the Artist's group name to the remaining members of Artist." FIRST RECORDING *supra* note 149, at 1.12. Along with such an acknowledgement, the leaving member also agrees to refrain from using the group name in the future. *See, e.g.,* HANDBOOK *supra* note 148, at 144-45 n.2. Such a ban may be absolute, so that the use of a "formerly of" label may be prohibited. *See, e.g.,* *Fuqua v. Watson*, 107 U.S.P.Q. (BNA) 251 (N.Y. Spec. Term 1955). However, leaving member provisions often expressly permit the use of the "formerly of" label. *See, e.g.,* *Five Platters, Inc. v. Purdie* 419 F. Supp. 372, 377 (D. Md. 1976).

In some cases, such permission is limited. *See, Sample Recording Agreement*, ENTERTAINMENT, ARTS, AND SPORTS LAW 200 (ALI-ABA 1991) [hereinafter *Sample Agreement*]. Under Paragraph 27(b) of that agreement, a leaving member is prohibited from billing himself as "formerly a member of [group name] except in advertisements relating solely to the first album recorded by such Leaving Member after becoming a Leaving Member . . ." *Id.* at 258.

Even in the absence of an initial assignment, such a transfer may nevertheless occur when a member later leaves the group. *Fuqua v. Watson*¹⁵¹ charted the internal squabbles of a vocal quartet called the "Ink Spots," which featured Charles Fuqua, William Kenny, Orville Jones, and Ivory "Deek" Watson. This quartet, formed in 1934, performed successfully for ten years without entering into any formal agreements concerning the group's structure or the ownership of the group's name.¹⁵² However, in 1944, Jones died and Fuqua was drafted into the armed services. These events prompted the three surviving members and Jones' widow to enter into a formal agreement in 1945. Under this agreement, Watson, as a leaving member, released "any and all right and interest in and to the name and trade name 'Ink Spots'"¹⁵³

Along with the formalization of the group's structure, initial success generally brings formal agreements with a manager and a recording label. The band's manager is responsible for providing the band with advice and counsel on matters such as the selection of musical materials and the preparation and dissemination of publicity and advertising materials.¹⁵⁴ Thus, it is essential that the band secure the most competent managerial services available.¹⁵⁵ In an attempt to secure these serv-

151. 107 U.S.P.Q. (BNA) 251 (N.Y. Spec. Term 1955).

152. *Id.* The group's hits included "Into Each Life Some Rain Must Fall" and "I Don't Want to Set the World on Fire." *Suit Served Up Over the Platters*, CHI. TRIB., June 19, 1986, at 13F.

153. The relevant portions of the agreement stated as follows:

Ivory D. Watson hereby releases . . . any and all right and interest in and to the name and trade name "Ink Spots" or "The Ink Spots," and in and to any joint venture or partnership that has been heretofore or may hereafter be conducted under said name or trade name; and Ivory D. Watson further covenants and agrees that he will at no time make use of said name or trade name in any manner, directly or indirectly, or employ or use, directly or indirectly, any colorable imitation thereof; nor shall he employ in the future, in any advertising display, or public or private announcement, any words such as "formerly of The Ink Spots" or any other words whether or not similar or dissimilar in character which may be designed to, or which may have the tendency of, affording Watson the opportunity of commercially and professionally exploiting for his own benefit said name or trade name.

107 U.S.P.Q. at 251.

This agreement further provided that Kenny and Fuqua shall have the right to . . . continue the joint venture as surviving members of the joint venture heretofore and now being conducted under the name "Ink Spots," which is to continue to be the name and property of both Kenny and Fuqua

Id.

154. See S. SHEMEL & M. KRASILOVSKY, *THIS BUSINESS OF MUSIC* 84-85 (5th ed. 1985); Note, *Badlands: Artist-Personal Manager Conflicts in the Music Industry*, 9 CARDOZO ARTS & ENT. L.J. 901 (1991). For a reproduction of a typical management agreement, see COUNSELING CLIENTS *supra* note 148, at 183.

155. See S. SHEMEL & M. KRASILOVSKY, *supra* note 154, at 85-86.

ices, the band may decide to trade valuable assets, including the group name.¹⁵⁶

The thirty-plus year history of The Drifters illustrates several such assignments. The Drifters first began to perform in 1953.¹⁵⁷ Shortly after the group formed, it entered into a management agreement with George Treadwell.¹⁵⁸ In return for Treadwell's management services, the members each assigned all rights in the group's name to Treadwell.¹⁵⁹

A later incarnation of The Drifters¹⁶⁰ began to perform in 1969 and came under the management of Larry Marshak in 1971.¹⁶¹ In 1976, in an apparent attempt to stem the proliferation of groups performing under the name "The Drifters," Marshak encouraged his group to complete an application to register their name under the Lanham Act.¹⁶² Marshak then told the group that, if they would assign to him all their rights under this application, he would continue to serve as their manager and would act vigilantly to stop others from using "The Drifters"

156. See, e.g., *HEC Enters., Ltd. v. Deep Purple, Inc.*, 213 U.S.P.Q. (BNA) 991, 992 (C.D. Cal. 1980), where the members of the rock band Deep Purple assigned their group name to a management corporation in return for promotion and management services. The use of the name was, however, subject to approval by a majority vote of the current members of the band. *Id.* at 993.

See also *Capetola v. Orlando*, 463 F. Supp. 498, 500 (E.D. Pa. 1978), where a young singer performing under the name of "Dawn" assigned her rights in the name to her parents' management corporation.

157. The group originally featured Clyde McPhatter, Gerhard and Andrew Thrasher, and Bill Pinkney. *HARMONY*, *supra* note 3, at 49. See also *ROLLING STONE*, *supra* note 3, at 16.

158. The group achieved its greatest success under Treadwell's management. During the late 1950s and 1960s, the group, which then featured Doc Green, Charles Thomas, and Elsbeary Hobbs, recorded standards such as "There Goes My Baby" and "Save The Last Dance For Me." *Marshak v. Green*, 505 F. Supp. 1054, 1056 (S.D.N.Y. 1981). Despite numerous changes in its membership, Treadwell's group continued to record through 1966. *Id.* at 1057.

159. *Marshak v. Sheppard*, 666 F. Supp. 590, 593 (S.D.N.Y. 1987). The various singers who were hired by Treadwell to replace occasional leaving members also apparently assigned their rights in the name to Treadwell. *Id.*

After Treadwell died in 1967, his widow Faye Treadwell continued to manage the group. Under her management, the group performed primarily in Europe. *Id.*

160. This incarnation, which was born in 1969, featured Doc Green, Charles Thomas, and Elsbeary Hobbs. *Marshak v. Green*, 505 F. Supp. at 1057. See also *Marshak v. Sheppard*, 666 F. Supp. at 593.

161. *Marshak v. Green*, 505 F. Supp. at 1057. This version of the group performed "with significant continuity and popularity." *Marshak v. Sheppard*, 666 F. Supp. at 593.

162. *Marshak v. Green*, 505 F. Supp. at 1057-58. The group filed this application in their capacity as a partnership. *Marshak v. Sheppard*, 666 F. Supp. at 594.

name.¹⁶³ The group accepted their manager's offer and assigned their registration rights to him.¹⁶⁴

A performing group may likewise decide to trade its name to a record producer or label¹⁶⁵ in return for what the band at the time perceives to be a lucrative recording contract.¹⁶⁶ A complicated version of such a trade can be found in *Bell v. StreetWise Records, Ltd.*¹⁶⁷ In late 1982, the young members of The New Edition,¹⁶⁸ a Boston area vocal group, secured a recording contract with StreetWise Records, Ltd.¹⁶⁹ In entering into this agreement, the group members each confirmed¹⁷⁰ that the group

163. *Marshak v. Green*, 505 F. Supp. at 1058. Marshak has indeed lived up to his promise: as recently as 1990, Marshak instituted an infringement action against Lands End, Inc., a clothing manufacturer, for its use of The Drifters' name in its August 1990 catalogue. *Manager of Drifters Sues Lands End Over Mark; Apparel Mail Order Company Accused of Infringing on Music Groups [sic] Trademarked Name*, 160 WOMEN'S WEAR DAILY 25 (1990).

164. *Marshak v. Green*, 505 F. Supp. at 1058.

165. Where the artist is a so-called "studio" or "concept" group, an express contractual allocation to the producer or label may well result. Cf. *Gutkowski v. Jeckell*, N.Y. L.J. Nov. 26, 1968, at 16.

166. The financial remuneration that accompanies a successfully-negotiated recording contract can be mind-boggling. Aerosmith recently signed a \$50 million, four album deal with Columbia Records. David Zimmerman, *Aerosmith: \$50 Million Band*, U.S.A. TODAY, Aug. 15, 1991, at 2D. This contract reputedly makes Aerosmith the world's highest-paid rock band. *Id.*

Michael Jackson apparently holds the title for solo artists, with a \$65 million-plus, six album contract with Sony, Inc., which bought CBS Records in 1988. Robert Hilburn & Chuck Philips, *Cover Story, Keeping Up With the Jacksons*, L.A. TIMES, Jun. 16, 1991, Calendar, at 8. Jackson's sister Janet is not far behind, with a \$40 million-plus, three album deal with Virgin Records. *Id.* When Janet's previous agreement with A & M Records expired in the spring of 1991, eight different labels, including A & M, Capitol, MCA, and Atlantic, submitted bids for her services. *Id.*

167. 761 F.2d 67 (1st Cir. 1985), *appeal after remand*, 787 F.2d 578 (1st Cir. 1986).

168. At that time, all members of the group were minors. *Id.* at 69.

169. The primary architect of this agreement was Maurice Starr. See *supra* note 90 for Starr's pedigree.

170. Each of the five members of the group entered into a separate agreement with StreetWise. 761 F.2d at 70.

name was owned by Boston International Records.¹⁷¹ Boston International Records in turn ceded "joint rights" in the name to StreetWise.¹⁷²

II

Infringement of the Names of Popular Music Groups

Ownership of a popular music group's name may thus be established either by priority of control or by contractual allocation. Once ownership has been established, the Lanham Act provides the owner with protection from infringing uses. In the absence of a contract, whether an infringement has occurred is determined solely according to the principles of trademark law. However, where a contract exists, the court must balance the principles of trademark law against those of contract law in order to determine an infringement.

A. Trademark Protection Against Infringement in the Absence of a Contractual Allocation of a Popular Music Group's Name

To establish an infringement under trademark law, an owner of a mark must demonstrate that public confusion is likely to result from the defendant's use.¹⁷³ Because the focus is upon possible deception of the public,¹⁷⁴ likelihood of confusion should be scrutinized through the eyes

171. Paragraph 1.d. of each of these contracts (except for the one signed by Ralph Tresvant), which were executed in November and December 1982, specifically provided that Artist performs in a musical group named *The New Edition* and confirms that the name is wholly owned by Boston International Records Inc. [sic], and that Artist has no right or interest in and to the name.

Id.

Starr was a partner of Boston International Records (BIR), which in 1983 assigned all its rights and obligations to Boston International Music Inc., a Massachusetts corporation listing Starr as its president. *Id.*

172. On October 8, 1982, BIR and StreetWise had entered into an agreement providing that "StreetWise and BIR jointly hold the exclusive rights to the use of the 'New Edition' mark in the musical recording industry." *Id.*

However, an established band with sufficient bargaining power may well be able to secure a lucrative recording agreement without having to sacrifice ownership of its name. See *Sample Agreement*, *supra* note 150, at 200. Under Paragraph 27(b) of that agreement, which is rated as "favorable" to the artist recording group, the producer expressly warrants that the artist is the sole owner of the group name. *Id.* at 258. Furthermore, in Paragraph 7 of the group inducement agreement that accompanies this contract, the artist expressly warrants that it is and will remain the sole owner of the group name. *Id.* at 295.

173. 15 U.S.C. § 1125(a) (1988). See also *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976), *rev'd and remanded on other grounds*, 572 F.2d 574 (7th Cir. 1978). The notion of "likelihood of confusion" applies equally to trade and service marks and trade names. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1366 (D.N.J. 1981).

174. Under subsection (a)(2) of section 43 of the Lanham Act, public deception can also be demonstrated by a showing of misrepresentation. In *CBS, Inc. v. Springboard Int'l Records*, 429 F. Supp. 563, 565 (S.D.N.Y. 1976), CBS, Charlie Rich, and the members of LaBelle sought to enjoin Springboard Records from releasing albums with misleading labels. In Rich's

of an ordinary purchaser buying with ordinary caution.¹⁷⁵ Thus, the essential inquiry must be whether an appreciable number of ordinarily prudent customers are likely to be confused or misled by multiple uses of a mark.¹⁷⁶

When two parties use the same mark for similar products or services,¹⁷⁷ the likelihood that an appreciable number of consumers may be confused is often easy to discern and may indeed be conceded by the parties.¹⁷⁸ However, in many cases involving alleged infringements of popular music group names, likelihood of confusion is a major point of

case, the album, entitled "Charlie Rich—The Entertainer," contained songs recorded by Rich in the 1950s and 1960s but featured a current photograph of Rich on both the front and the back. Rich complained that the use of old recordings with his current likeness was misleading, since his style and appearance had changed greatly over the years. *Id.*

In the case of LaBelle, Springboard released two albums entitled "La Belle [sic] & The Bluebelles Early Hits" and "Merry Christmas From La Belle [sic] & The Bluebelles." These albums contained recordings made while the three members of LaBelle had been members of a group known as "Patti LaBelle and the Bluebelles." The members of LaBelle complained that the use of the old recordings with the name of their present group was misleading, since the styles of "Patti LaBelle and the Bluebelles" and "LaBelle" were radically different: the former group used only one lead singer, with all members performing in uniform formal evening wear, while the latter group featured all of the group's members on lead vocals, with each member wearing a different "bizarre" costume. *Id.*

In both cases, the court found that the labelling of the albums in question clearly misled members of the consuming public into believing that they were purchasing something other than what they actually got. As a result, the court found a violation of section 43(a)(2). *Id.* at 569.

For similar cases successfully maintained by Rich against other labels for which he had previously recorded, see *Rich v. RCA Corp.*, 390 F. Supp. 530 (S.D.N.Y. 1975) and *CBS, Inc. v. Gusto Records, Inc.*, 403 F. Supp. 447 (M.D. Tenn. 1974).

175. *Estate of Presley*, 513 F. Supp. at 1370.

176. *Marshak v. Green*, 505 F. Supp. 1054, 1058 (S.D.N.Y. 1981).

The typical Lanham Act case involves "forward confusion," in which a lesser-known junior user infringes upon a better-known senior user. *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 408 F. Supp. 1219 (D. Colo. 1976), *aff'd*, 561 F.2d 1365 (10th Cir. 1977), *cert. dismissed*, 434 U.S. 1052 (1978). However, the Act also protects against "reverse confusion," which occurs when a little-known senior user is infringed upon by a more powerful junior user. See, e.g., *Pump, Inc. v. Collins Management, Inc.*, 746 F. Supp. 1159 (D. Mass. 1990) (A local, anti-drug, bodybuilding rock band named Pump complained of reverse confusion when the well-known rock band Aerosmith entitled its latest album "Pump."); *Big O Tire Dealers*, 408 F. Supp. at 1219 (A relatively unknown tire company called Big O Tire Dealers, which had been marketing a tire called Big Foot, sued Goodyear Tires when the latter began to market a tire called Bigfoot.).

177. See, e.g., *Marshak v. Green*, 505 F. Supp. 1054; *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372 (D. Md. 1976).

178. See *Three Degrees*, *supra* note 36. In that case, the two competing factions of the group The Three Degrees not only conceded but also affirmatively argued that their conflicting uses of the group's name created a likelihood of confusion. For similar concessions, see *Bell v. StreetWise Records, Ltd.*, 640 F. Supp. 575, 579 (D. Mass. 1986) and *Rick v. Buchansky*, 609 F. Supp. 1522, 1530 (S.D.N.Y.), *appeal dismissed*, 770 F.2d 157 (2d Cir. 1985).

debate.¹⁷⁹ In the absence of a specific contract, the determination of whether such confusion may occur depends upon all of the relevant circumstances surrounding the multiple use of a name.¹⁸⁰

In examining these circumstances, courts traditionally consider a number of factors, including the strength of the plaintiff's mark; the similarity of the marks; the similarity of goods or services; the channels of trade, marketing methods, and prospective purchasers; the defendant's intent; and actual confusion.¹⁸¹ No one factor is dispositive; rather, the court must weigh the cumulative impact.¹⁸²

1. *Strength of the Plaintiff's Mark*

A "strong" mark is entitled to greater protection against infringement than is a "weak" mark.¹⁸³ The strength of a mark for the purpose of determining likelihood of confusion is related to the distinctiveness of a mark for the purpose of determining initial validity.¹⁸⁴ The more distinctive a mark is, the stronger and hence more durable the mark tends to be.¹⁸⁵ As the court explained in *Rick v. Buchansky*,¹⁸⁶ the arbitrariness of the mark in the group name "Vito and the Salutations" rendered that mark strong in the assessment of likelihood of confusion.¹⁸⁷

Secondary meaning may likewise contribute to the strength of a mark for the purposes of likelihood of confusion. Thus, the strength of the "Vito and the Salutations" mark derived not only from the distinctiveness of the mark but also from the secondary meaning that it had acquired over twenty-three years of public use.¹⁸⁸

179. See, e.g., *Pump, Inc.*, 746 F. Supp. at 1165; *Grondin v. Rossington*, 690 F. Supp. 200, 209 (S.D.N.Y. 1988); *Rick*, 609 F. Supp. at 1529.

180. *Bell v. StreetWise Records, Ltd.*, 761 F.2d 67, 76 (1st Cir. 1985), *appeal after remand*, 787 F.2d 578 (1st Cir. 1986). These circumstances may include the history of the parties' relation to each other and their likely understandings. *Id.*

181. *Pump, Inc.*, 746 F. Supp. at 1167; *Estate of Presley v. Russen*, 513 Supp. 1339, 1366 (D.N.J. 1981); *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1170 (2d Cir. 1979); *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372, 381 (D. Md. 1976).

182. *Pump, Inc.*, 746 F. Supp. at 1167.

183. *Id.* at 1170.

184. *Estate of Presley*, 513 F. Supp. at 1362-63.

185. *Id.* at 1366-67.

186. 609 F. Supp. 1522 (S.D.N.Y.), *appeal dismissed*, 770 F.2d 157 (2d Cir. 1985).

187. 609 F. Supp. at 1530.

188. *Id.* See also *Dolby v. Robertson*, 654 F. Supp. 815 (N.D. Cal. 1986), where the court noted that the mark "Dolby Stereo" is not, in and of itself, particularly strong for the purpose of likelihood of confusion. However, the mark is very well-known and thus "probably carries a secondary meaning." *Id.* at 819.

See also *Estate of Presley*, 513 F. Supp. at 1365 (The mark in Elvis Presley's name was strong for the purpose of determining likelihood of confusion because Presley's name had, over the years, acquired significant secondary meaning.).

However, in assessing strength for the purposes of likelihood of confusion, the court may consider certain additional factors: the length of time the mark has been used and the plaintiff's renown in the field, the strength of the mark in the field, and the plaintiff's actions in promoting the mark.¹⁸⁹ In *Pump, Inc. v. Collins Management, Inc.*,¹⁹⁰ the court considered these factors in weighing the strength of the mark claimed by an anti-drug, bodybuilding band called "Pump."¹⁹¹ This local Massachusetts band objected when the rock band Aerosmith¹⁹² entitled its most recent album "Pump."¹⁹³ The Massachusetts band had failed to secure a recording contract, thus demonstrating that neither the band nor its mark had become well-known in the music industry.¹⁹⁴ Furthermore, the band, which had only begun to use the mark in 1987, had been largely inactive following the institution of the instant suit in 1988. As a result, "Pump" was found to be extremely weak for the purpose of determining likelihood of confusion.¹⁹⁵

2. Similarity of the Marks

The second factor that the courts consider in determining likelihood of confusion is the similarity of the marks used by the plaintiff and the defendant. The marks may be identical when the plaintiff and the defendant were once part of the same musical group and each later claims the right to use the group's name. Changes in the membership of well-known groups such as the Platters,¹⁹⁶ the Drifters,¹⁹⁷ Rare Earth,¹⁹⁸

189. *Pump, Inc. v. Collins Management, Inc.*, 746 F. Supp. 1159, 1169-70 (D. Mass. 1990).

190. *Id.* at 1159.

191. "Pump" stands for "Promoting Unlimited Mind Power." *Id.* at 1163. The band's name had been chosen with an eye toward the group's stated purpose, which was to promote physical self-improvement as an alternative to drugs, thereby providing a positive role model for teenagers. *Id.* at 1161, 1163.

192. Aerosmith's membership includes Steven Tyler, Joe Perry, Brad Whitford, Tom Hamilton, and Joey Kramer. HARMONY, *supra* note 3, at 9. This band, which was formed in 1970, has recorded numerous hits, including "Walk This Way," "Sweet Emotion," and "Janie's Got a Gun."

193. The band Pump was particularly perturbed by Aerosmith's use of "Pump" on its latest album because Aerosmith had a past history of alleged drug use. *Pump, Inc.*, 746 F. Supp. at 1164, 1166 n.11. However, the members of Aerosmith have now publicly eschewed drugs. *Id.* In fact, on a November 1989 MTV special, Whitford explained that Pump was chosen as the title for the band's latest album because "[n]ow that we're off drugs we're all pumped up." *Id.* at 1164. See also Greg Kot, *It's Aerosmith, The Band that Booze and Drugs Destroyed Has it Together Again*, CHI. TRIB., July 15, 1990, Arts, at 4.

194. Until December 19, 1989, the band had played at most 20 concerts, all of which had been at local high schools as part of anti-drug rallies. *Pump, Inc.*, 746 F. Supp. at 1171.

195. *Id.*

196. See *supra* for the lengthy legal history of this group.

197. See *supra* for the history of the Drifters.

198. *Rare Earth, Inc. v. Hoorelbeke*, 401 F. Supp. 26 (S.D.N.Y. 1975). See *supra* for the history of Rare Earth.

Deep Purple,¹⁹⁹ Lynyrd Skynyrd,²⁰⁰ Jay and the Americans,²⁰¹ The Byrds,²⁰² Jefferson Airplane,²⁰³ and Pink Floyd²⁰⁴ have all spawned trademark litigation between present and former members who have engaged in conflicting uses of identical marks.

In some cases, however, two bands that have no connection may inadvertently adopt identical or virtually identical names. *Sideshow, Inc. v. Mammoth Records, Inc.*²⁰⁵ involved two unconnected bands that had unknowingly adopted virtually identical names. The name "Sidewinder" was first adopted in the late 1970s by a North Carolina band. Several years later, an Arizona band began to perform and record under the

199. *HEC Enters., Ltd. v. Deep Purple, Inc.*, 213 U.S.P.Q. (BNA) 991 (C.D. Cal. 1980). Deep Purple was organized in 1968 in Great Britain. It originally featured Ian Paice, Ritchie Blackmore, Jon Lord, Rod Evans, and Nicky Simper. In 1969, Roger Glover and Ian Gillan replaced Evans and Simper, and in 1973, Glover and Gillan were replaced by David Coverdale and Glenn Hughes. Blackmore then left in 1975 and was replaced by the late Tommy Bolin. *Id.* at 992.

200. *Grondin v. Rossington*, 690 F. Supp. 200 (S.D.N.Y. 1988). See *infra* for the history of Lynyrd Skynyrd.

201. Jay (born John) Trainer founded Jay and the Americans in 1960. Trainer left the group in 1962 and was replaced by Jay (born David) Black, who recorded hits such as "Come a Little Bit Closer" and "This Magic Moment." In March 1988, Trainer began to use the group's name in comeback concerts. Black promptly filed a \$1 million suit to stop Trainer from using the name. Michael Fleming & Karen Freifeld, *Inside New York*, NEWSDAY, June 16, 1989, at 11.

202. The Byrds were formed in 1964 by Jim (later Roger) McGuinn, David Crosby, Chris Hillman, Gene Clark, and Michael Clarke. Mike Boehm, *Byrds Battle for the Rights to the Name*, L.A. TIMES, Jan. 5, 1989, at 1. See also HARMONY, *supra* note 3, at 25. After recording hits such as "Eight Miles High," "Turn! Turn! Turn!," and "Mr. Tambourine Man," the members of this folk-rock group went their separate ways in 1968. Harry Sumrall, *Byrd Fight—2 Bands Bearing Original's Name Squabble Over a '60s Legacy*, CHI. TRIB., Mar. 2, 1989, at 13C. Fifteen years later, Clarke began to tour as "The Byrds featuring Michael Clarke." Boehm, *supra*. McGuinn, Crosby, and Hillman quickly put together a gig in order to reestablish control of the group name. *Id.* A Florida court ruled that Clarke, who was joined by Gene Clark, could perform as "The Byrds"; however, Clark later decided to drop that name in a successful bid to appease his fellow original Byrds before the group was inducted into the Rock 'n' Roll Hall of Fame in January 1991. Gene Clark, *Byrds Singer-Songwriter, Dead at 46*, Proprietary to the United Press International 1991, May 25, 1991.

203. The Jefferson Airplane, formed in 1965, was the quintessential San Francisco band. During the mid-1960s, Paul Kantner, Grace Slick, Marty Balin, Jack Casady, Jorma Kaukonen, and Spencer Dryden recorded psychedelic classics such as "White Rabbit" and "Somebody to Love." HARMONY, *supra* note 3, at 34-35. See also ROLLING STONE, *supra* note 3, at 272. By 1974, only Kantner and Slick remained of the original members. HARMONY, *supra* note 3, at 34-35. The band therefore changed both name and direction, becoming Jefferson Starship. *Id.* In 1984, Kantner and Slick became embroiled in litigation with then-member Mickey Thomas. The case was settled, leaving Thomas and others, but minus Kantner and Slick, to perform under the name Starship. In 1989, Kantner, Slick, Balin, Casady, and Kaukonen reunited as Jefferson Airplane. Jon Pareles, *On-Again Off-Again Jefferson Airplane Is on Again*, N.Y. TIMES, Aug. 29, at C11.

204. See *supra* note 46.

205. 751 F. Supp. 78 (E.D. N.C. 1990).

name "Sidewinders."²⁰⁶ Neither group, however, had any knowledge of the other until 1990, when the North Carolina band played in a "Coors Light" commercial.²⁰⁷

A defendant's mark need not be virtually identical to the plaintiff's in order to be actionable. Rather, the greater the similarity between the plaintiff's and defendant's marks, the greater the likelihood of confusion.²⁰⁸ *Stuart v. Collins*²⁰⁹ featured a little-known performer who had been performing under the name "The Rubberband."²¹⁰ Ten years later, without knowledge of the plaintiff's use, another performer began to perform under the name "Bootsy's Rubber Band."²¹¹ The court took substantial note of the similarity between the names and found that the defendant's use was bound to cause a likelihood of confusion in the record market.²¹²

The fact that the same or similar word is used as a mark by both the plaintiff and the defendant does not, however, automatically result in a finding of unacceptable similarity. Rather, the court must consider factors such as similarity of appearance, pronunciation, and meaning.²¹³ In *Pump, Inc. v. Collins Management, Inc.*,²¹⁴ the court considered the similarities of the marks used by the bands Pump and Aerosmith. Both bands did use the word "Pump" prominently, with identical spelling. However, the design of the marks differed greatly: the plaintiff band used a stylized logo consisting of lower case letters resting on musical notes,²¹⁵

206. In 1990, this band released an album entitled "Auntie Ramos' Pool Hall."

207. See also *Anderson v. Capitol Records, Inc.*, 178 U.S.P.Q. (BNA) 238, 239 (Cal. Super. Ct. 1973). In the late 1960s and early 1970s, the group name "Flash" was unknowingly adopted by two rock bands, one located in the San Francisco Bay Area and the other in England.

See also *Dolby v. Robertson*, 654 F. Supp. 815 (N.D. Cal. 1986) (defendant's stage surname "Dolby" was identical to the trademark held by the inventor of the "Dolby" noise reduction system).

208. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1367 (D.N.J. 1981). Indeed, some courts have gone so far as to state that a person who uses a mark similar to one already in use generally has an affirmative duty to avoid likelihood of confusion. *Pump, Inc. v. Collins Management, Inc.*, 746 F. Supp. 1159, 1167 (D. Mass. 1990); *Boston Athletic Ass'n v. Sullivan*, 867 F.2d 22 (1st Cir. 1989).

209. 489 F. Supp. 827 (S.D.N.Y. 1980).

210. The performer was Thomas Stuart, a resident of Birmingham, Alabama. *Id.*

211. This artist was Bootsy Collins, a bass player who had performed with a number of popular bands, including James Brown and Parliament. *Id.*

212. *Id.* at 831.

213. *Estate of Presley*, 513 F. Supp. at 1367. In that case the court focused on appearance in finding some but not overwhelming similarity between the name "Elvis Presley" and the words "El" and "The Big El Show." *Id.*

214. 746 F. Supp. 1159 (D. Mass. 1990).

215. The plaintiff band claimed that the foundation consists of musical notes; Aerosmith, however, alleged that the foundation actually represents a barbell. *Pump, Inc.*, 746 F. Supp. at 1167.

while, on its album, Aerosmith used the word simply, with bold capital letters printed on the door of a truck. Furthermore, the Aerosmith logo was displayed on the album in close proximity to the word "Pump."²¹⁶ Thus, any similarity between the marks was deemed to be tenuous and inconsequential.²¹⁷ Such limited similarity alone did not, in the court's view, mandate a finding of likelihood of confusion.²¹⁸

3. *Similarity of the Goods or Services*

As with similarity of marks, the greater the resemblance between the goods or services provided by the plaintiff and the defendant, the greater the opportunity for consumer confusion.²¹⁹ Where two popular music groups are involved, the chances of product similarity are often great. In *Cesare v. Work*,²²⁰ the court considered the trade dress of two bands, one called "Revolver" and one called "1964."²²¹ The two bands performed as "Revolver" or "formerly Revolver." Furthermore, they shared substantially similar, if not identical, endorsements and accolades, advertising packages and folders, and audience participation and band pattern routines. The court therefore found substantial similarity of trade dress.²²²

In *Pump, Inc.*, the court also considered product similarity. Aerosmith claimed that the products involved were dissimilar, because Aerosmith used "Pump" as the title of an album, while the plaintiff used it as the name of a band. However, the court determined that the products were similar, since both bands use the word "Pump" to promote a wide variety of goods and services associated with musical entertainment.²²³

216. The Aerosmith logo, which is a federally registered trademark, consists of the word "Aerosmith" in stylized form, against the background of a stylized "A" with a star and a pair of open wings. *Id.* at 1164.

217. *Id.* at 1167.

218. *Id.*

219. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1367-68 (D.N.J. 1981).

220. 520 N.E.2d 586 (Ohio Ct. App. 1987).

221. Both bands emulated the Beatles. "Revolver" is the name of one of the Beatles' albums, which contains classics such as "Tax Man," "Eleanor Rigby," and "Here, There, and Everywhere." 1964 is the year in which the Beatles first toured the United States. *See ROLLING STONE*, *supra* note 3, at 177-89; *see also HARMONY*, *supra* note 3, at 14-15.

222. *See HEC Enters., Ltd. v. Deep Purple, Inc.*, 213 U.S.P.Q. (BNA) 991, 993 (C.D. Cal. 1980) (The defendant Deep Purple band performed only songs performed by the plaintiff Deep Purple band and in a style imitating that made famous by the plaintiff band.).

223. *Pump, Inc. v. Collins Management, Inc.*, 746 F. Supp 1159, 1167 (D. Mass 1990).

See also Rick v. Buchansky, 609 F. Supp. 1522, 1543 (S.D.N.Y.) (entertainment services provided by two groups performing under the name "Vito and the Salutations" were found to be "if not virtually identical, then exceedingly similar"), *appeal dismissed*, 770 F.2d 157 (2d Cir. 1985); *Tin Pan Apple, Inc. v. Miller Brewing Co.*, 737 F. Supp. 826, 836 (S.D.N.Y. 1990) (Miller's Fat Boys parody commercial held substantially similar to the performances rendered by the Fat Boys rap group, since the participants in the commercial closely resembled the

4. Channels of Trade, Marketing Methods, and Prospective Purchasers²²⁴

In determining likelihood of confusion, courts must also take into account the channels of trade serviced by the plaintiff and the defendant, the marketing methods employed to reach those channels, and the type of purchasers intended to be reached in those channels.²²⁵ In considering these factors, the court must thus determine whether the parties have similar potential markets and whether they seek to exploit those markets in similar ways.²²⁶

Both bands in *Pump, Inc.* had attempted to reach a national market by seeking to secure music store sales, radio and video royalties, and live concert bookings.²²⁷ Furthermore, both bands advertised, or intended to advertise, through posters, tee shirts, jewelry, and media exposure. Finally, both groups appealed to "young persons who enjoy rock music." From these facts, the court determined that the bands shared a "nearly identical" class of prospective purchasers.²²⁸ The channels of trade, marketing methods, and prospective purchasers of the two bands were therefore deemed to be similar.²²⁹

plaintiff rappers in particular physical characteristics (obesity) and performance styles (rapping)); *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1368 (D.N.J. 1981) (services of the late Elvis Presley and the defendant deemed similar because both consisted of musical entertainment provided by one performer with instrumental or vocal background provided by others); *Marshak v. Green*, 505 F. Supp. 1054 (S.D.N.Y. 1981) (two competing groups called "The Drifters" performed in the same style).

In assessing similarity of product, some courts also inquire whether the plaintiff is apt to "bridge the gap" between his product and the defendant's. See *Rick*, 609 F. Supp. at 1543. In making this inquiry, the court considers whether the senior user is likely to expand his product lines into the area currently occupied by the junior user. *Id.* See also *Dolby v. Robertson*, 654 F. Supp. 815 (N.D. Cal. 1986). However, bridging the gap generally does not need to be considered in cases involving popular music groups, since the plaintiff and defendant are usually already in direct competition. *Rick*, 609 F. Supp. at 1543.

224. Many courts consider these factors together. See, e.g., *Pump, Inc.*, 746 F. Supp. at 1168; *Estate of Presley*, 513 F. Supp. 1339.

225. *Estate of Presley*, 513 F. Supp. at 1369.

226. *Pump, Inc.*, 746 F. Supp. at 1169.

227. *Pump, Inc.*, 746 F. Supp. at 1168. Aerosmith had, however, been substantially more successful in securing these items. *Id.* at 1169.

228. *Id.* at 1168-69. Aerosmith had argued that Pump is a "gimmick group" that appeals solely to an audience limited to persons interested in bodybuilding, while Aerosmith is an internationally known band with widespread audience appeal. *Id.* at 1168.

229. See *Rick v. Buchansky*, 609 F. Supp. 1522 (S.D.N.Y.) (Two groups named "Vito and the Salutations" competed for bookings on the "doo-wop" revival circuit.), *appeal dismissed*, 770 F.2d 157 (2d Cir. 1985); *Green v. Marshak*, 505 F. Supp. 1054 (S.D.N.Y. 1981) (Two groups called "The Drifters" attempted to secure bookings in the same geographic area.).

Relative success or failure of either party in reaching its intended market has no bearing on a finding of market similarity. As the *Pump* court explained, "[t]he key here is not which group is more popular or which group tours more or which group has more money—but rather whether the parties have similar potential markets and seek to exploit those markets in similar ways." 746 F. Supp. at 1169. See also *Stuart v. Collins*, 489 F. Supp. 827 (S.D.N.Y.

In weighing market similarities, some courts have placed special emphasis on the relative sophistication of prospective purchasers.²³⁰ In *Grondin v. Rossington*,²³¹ the widow of singer Ronnie Van Zant asked the court to determine whether consumer confusion was likely to result from a 1987-88 live concert tour and tour album produced by the surviving members of the Southern rock band Lynyrd Skynyrd.²³² In assessing the effect of the live performances, the court first noted that the October 1977 crash that killed lead singer Van Zant and another member of the band had been highly publicized. Furthermore, promotional materials for the tour did not contain photographs of the old band.²³³ Sophisticated fans of the original Lynyrd Skynyrd were therefore unlikely to be confused by the 1987-88 concert tour. As the court explained, "seasoned concert-goers are unlikely to believe Ronnie Van Zant has risen from the grave to perform on tour"²³⁴

1980), where the court noted that an owner of a mark should not lose legal protection just because his best efforts have not yet succeeded in winning fame for his mark. *Id.* at 830 n.11.

230. See, e.g., *Dolby v. Robertson*, 654 F. Supp. 815 (N.D. Cal. 1986), where the court remarked that "[c]onsumers of popular music are likely to exercise care as to the identity of the musician. Consumers are *not* likely to exercise care as to the musician's biography." *Id.* at 820.

231. 690 F. Supp. 200 (S.D.N.Y. 1988).

232. Lynyrd Skynyrd was formed in the early 1970s by Ronnie Van Zant, Allen Collins, and Gary Rossington. According to the band's first album, the name is pronounced "'leh-'nérd 'skin-'nérd.'" The name was coined as a spoof on the name of their authoritarian high school gym teacher, Leonard Skinner. *Id.* at 202. See also HARMONY, *supra* note 3, at 105.

Van Zant, Collins, and Rossington were soon joined by Leon Wilkeson and William Powell. Steven Gaines and Artimus Pyle were later added to the band, which achieved great success during the first half of the 1970s, recording classics such as "Free Bird" and "Sweet Home, Alabama." On October 20, 1977, the band's tour plane crashed, killing Van Zant, Gaines, and two others. Ten years later, after serious debate, the surviving members, along with Ronnie's brother Johnny and Ronnie's father Lacy, plus several other musicians, set out on a tour that was billed as a tribute to Lynyrd Skynyrd. A tour album was subsequently released. *Grondin*, 690 F. Supp. at 202-03.

233. Concert programs did contain photographs of the original band. However, the program clearly labeled those photographs as historical. *Id.* at 209 n.8.

234. *Id.* at 209. Indeed, most fans in the crowd must have been only too aware. Rossington later reminisced about the first stop on the tour, which was at Charlie Daniels' 13th Annual Volunteer Jam in Nashville. The band played an instrumental version of "Free Bird," which was performed behind an empty microphone in tribute to Van Zant. According to Rossington, "[y]ou could here 16,000 people singing, and it sounded like a million It was real emotional." Duncan Strauss, *For Rossington, Skynyrd Tour Honors Memories*, L.A. TIMES, Sept. 26, 1987, at 6.

The *Grondin* court did note, however, that there were minor ways in which the tour might have deceived the unsophisticated concert-goer. Certain promotional material for the tour displayed a logo similar to one used on an older album that featured Ronnie Van Zant. Furthermore, unknowing potential consumers who had heard of the tour without hearing that it was a tribute might think that they were going to see the same band that had previously released well-known songs such as "Free Bird." *Grondin*, 690 F. Supp. at 209.

However, the court found that likelihood of confusion was greater with the album. Lynyrd Skynyrd albums containing performances recorded by the original members had continued to be released after the 1977 crash.²³⁵ As a result, even sophisticated album buyers might have no way of knowing whether the album in question, which bore the legend "Lynyrd Skynyrd Live," featured performances by the original or the reconstituted group.²³⁶

5. *Intent of the Defendant*

The defendant's intent in using the mark in question is also relevant to the question of likelihood of confusion.²³⁷ When the defendant's use of the mark has been innocent and in good faith, the balance may tip away from a finding of likely confusion.²³⁸ In *Pump, Inc.*, no evidence had been presented to show that Aerosmith intentionally appropriated the name of the plaintiff. Indeed, there was no evidence indicating that Aerosmith had even known of the plaintiff band before the instigation of the instant suit. As a result, the court found no proof that Aerosmith had acted in bad faith by attempting to hitch a free ride on the plaintiff's name.²³⁹

235. During the 10 years between the crash and the tribute tour, three albums were released that contained previously recorded and unreleased material. In addition, one compilation of previously released material was marketed. *Grondin*, 690 F. Supp. at 203.

236. *Id.* at 209. Although the tour album did carry the legend "Lynyrd Skynyrd Tribute Tour," the court found the words to be so small in comparison to the words "Lynyrd Skynyrd Live" as to be nearly meaningless. *Id.*

See also *Tin Pan Apple, Inc. v. Miller Brewing Co.*, 737 F. Supp. 826 (S.D.N.Y. 1990). In that case, which involved Miller's Fat Boys parody commercial, the court described the potential purchasers as "individuals who watch performances of rap music and individuals who drink beer." *Id.* at 835. As a result of the "wide net" cast by Miller, the court declared that "[o]ne cannot assume so great a degree of sophistication as to negate likelihood of confusion." *Id.* But see *Sugarhill Records, Ltd. v. Motown Record Corp.*, 570 F. Supp. 1217 (S.D.N.Y. 1983), where the court attributed substantial sophistication to the fans of the rap group Grand Master Flash. *Id.* at 1221.

See also *Pump, Inc. v. Collins Management, Inc.*, 746 F. Supp. 1159 (D. Mass. 1990). Aerosmith argued that music consumers use great care in purchasing albums. *Id.* at 1169 n.15. The court conceded that "many fans are clearly loyal to their favorite bands"; nevertheless, the court rejected Aerosmith's contentions. *Id.* at 1169. Instead, the court took judicial notice of the fact that compact discs are relatively inexpensive items that "are most often purchased by the casual purchaser without careful consideration." *Id.* Serious fans of rock music would undoubtedly dispute this conclusion.

237. *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1366 (D.N.J. 1981).

238. *Rick v. Buchansky*, 609 F. Supp. 1522, 1543 (S.D.N.Y.), *appeal dismissed*, 770 F.2d 157 (2d Cir. 1985).

239. *Pump, Inc.*, 746 F. Supp. at 1170.

However, many controversies concerning multiple conflicting uses of band names involve clear cases of intentional pirating.²⁴⁰ Where the defendant has intentionally used the plaintiff's name, the balance may well tip in favor of likelihood of confusion.²⁴¹ In *Marshak v. Green*,²⁴² David Rick,²⁴³ the manager of the defendant Drifters was particularly obvious about his intent to capitalize on the goodwill previously established by the plaintiff Drifters. Indeed, Rick admitted under oath that he had chosen the well-known name "Drifters" because "[t]he only thing that draws is a name that is well known or halfway known or whatever."²⁴⁴ Rick deliberately used a name that he knew he had no right to use; thus, he caused unacceptable confusion in the consuming public.²⁴⁵

6. Actual Confusion

The final factor used in determining whether the public is likely to be confused by multiple uses of a mark is evidence of actual confusion in members of the consuming public.²⁴⁶ Evidence of actual confusion is not absolutely required; however, where such evidence is completely lacking, the balance may begin to tilt away from a finding of likelihood of confusion.²⁴⁷ In *Pump, Inc.*, the plaintiff band attempted to prove actual confusion through the affidavits of four allegedly confused consumers. Each told a similar story: after seeing the "Pump" album displayed in a store or after hearing the album played on the radio, the confused consumer contacted the plaintiff, asking whether there was any connection.²⁴⁸ The

240. See, e.g., *Rick*, 609 F. Supp. at 1522 (Plaintiff David Rick succeeded in showing that the defendant group had intentionally used the name of the plaintiff group, Vito and the Salutations); *Stuart v. Collins*, 489 F. Supp. 827 (S.D.N.Y. 1980) (Warner Brothers Records was found to have willfully infringed upon the name of the plaintiff's group, Rubberband.); *HEC Enters., Ltd. v. Deep Purple, Inc.*, 213 U.S.P.Q. (BNA) 991 (C.D. Cal. 1980) (The defendant's use of the name "Deep Purple" was deliberate, willful, and wanton.); *Cesare v. Work*, 520 N.E.2d 586 Ohio Ct. App. 1987) (The defendant band intended to pirate many of the characteristics of their former band, Revolver.).

241. *Estate of Presley*, 513 F. Supp. at 1368.

242. 505 F. Supp. 1054 (S.D.N.Y. 1981).

243. Rick also managed other successful groups, including Vito and the Salutations. See *Rick*, 609 F. Supp. at 1522. Ironically, Rick won the latter case by proving that the defendants had intentionally pirated his group's name.

244. *Id.* at 1059 n.12. Rick further testified that he could not get bookings without using The Drifters' name. *Id.* And when asked by the court whether new performers could secure bookings under their own names, Rick answered "no." *Id.*

245. *Id.* See also *Tin Pan Apple, Inc. v. Miller Brewing Co.*, 737 F. Supp. 826 (S.D.N.Y. 1990). Miller originally asked the rap group Fat Boys to appear in one of its commercials. When the rappers declined to participate, Miller procured "look-alikes." The court found Miller's actions to be "bad faith raised to a higher power." *Id.* at 835.

246. *Estate of Presley*, 513 F. Supp. 1339.

247. *Pump, Inc. v. Collins Management, Inc.*, 746 F. Supp. 1159 (D. Mass. 1990).

248. *Pump, Inc.*, 746 F. Supp. at 1169-70.

court dismissed these affidavits, however, since all four admitted knowing that "Pump" was an Aerosmith album.²⁴⁹ In the end, the plaintiff failed to show that any consumer had bought the Aerosmith album thinking that it had been recorded by the band Pump.²⁵⁰ Thus, if anything, the proof demonstrated a lack of, rather than a likelihood of, confusion.²⁵¹

7. *Balancing the Factors*

After considering each of the factors discussed above, the court must balance them against each other in order to determine whether a likelihood of confusion, and thus an infringement, exists. In *Pump, Inc.*, the court carefully weighed the factors before it. On the one hand, the marks shared surface similarities; the products, marketing methods, and audience were substantially similar. On the other hand, the plaintiff's mark was weak, some dissimilarities existed in the marks, the defendant lacked wrongful intent, and little actual confusion was proven. The weight of the latter factors ultimately tipped the balance against a finding of likelihood of confusion.²⁵²

In other cases, however, the balance has tipped in favor of a finding of confusion and resultant infringement. For example, in *Cesare v. Work*,²⁵³ rival Beatles imitators were found to share not only similar names but also similar products and marketing methods.²⁵⁴ The combination of these shared factors led the court to a finding of likely consumer confusion.²⁵⁵

249. Furthermore, each of the four alleged consumers was a friend of a member of the plaintiff band. *Id.* at 1170. In any event, the court was not convinced that inquiries alone amount to sufficient evidence of actual confusion. *Id.* at 1169.

250. The court contrasted the facts of this case to those in *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 408 F. Supp. 1219 (D. Colo. 1976), *aff'd*, 561 F.2d 1365 (10th Cir. 1977), *cert. dismissed*, 434 U.S. 1052 (1978). When Goodyear, as the junior user, began to market its Bigfoot tires, customers who had previously bought the senior user Big O's Big Foot tires thought that their tires had been manufactured by Goodyear for Big O. 408 F. Supp. at 1229. Furthermore, when one Big O dealer attempted to advertise in the Yellow Pages under the legend "Home of Big Foot," the telephone company refused the ad, claiming that Bigfoot already belonged to Goodyear. *Id.*

251. *Pump, Inc.*, 746 F. Supp. at 1169. See also *Dolby v. Robertson*, 654 F. Supp. 815 (N.D. Cal. 1986). There the court took note of some "anecdotal" evidence of actual confusion. *Id.* at 820. The court also considered hearsay evidence, which consisted of defendant Thomas Dolby's admission that he was often asked if he was connected with the plaintiff's Dolby Labs. *Id.*

252. *Pump, Inc. v. Collins Management, Inc.*, 746 F. Supp. 1159, 1171 (D. Mass. 1990).

253. 520 N.E.2d 586 (Ohio Ct. App. 1987).

254. *Id.* at 592.

255. See e.g., *Marshak v. Green*, 505 F. Supp. 1054 (S.D.N.Y. 1981) (finding a likelihood of confusion because the defendant Drifters band acted in bad faith and because the rival

8. *Protection Against Infringement in the Event of a Contractual Allocation of a Popular Music Group's Name*

When a contractual allocation of a group name is added to the mix, the question of infringement becomes more complex.²⁵⁶ In some instances, an analysis of the factors discussed above raises the specter of consumer confusion from a use authorized by an otherwise valid agreement.²⁵⁷ In such cases, principles of both contract and trademark law must be taken into account before a finding of infringement can be properly made.²⁵⁸ Under contract law, a use authorized by a fair, bargained-

Drifters bands shared the same name, style, and geographic area of performance and competed directly).

256. Note that if a group's name does not qualify as a mark, infringement does not become an issue. In such a case, a contractual allocation of a name is governed solely by the principles of contract law.

257. To be valid, such an agreement must first be properly formed. See *Larkin v. Polygram Records, Inc.*, No. 86 Civ. 1128 (RWS), 1986 WL 6174 (S.D.N.Y. 1986), which involved the enforceability of a recording contract executed by the three original members of the group called "The Vels," through their corporation, and Polygram Records. Under this contract, the performers agreed to allow Polygram Records to use the group name in connection with records produced under the terms of the contract, even if individuals joined or left the group during that term. The court declared the agreement to be enforceable as written, since it "presents a case of legitimate, contractually-induced reliance on unambiguous contract terms . . ." *Id.* at *5.

However, where the elements of formation have not been satisfied, a contract is not enforceable. In 1974, a California superior court refused to enforce an agreement in which the members of The Platters transferred their rights in the group's name to a corporation owned by the group's manager. The agreement was deemed unenforceable because, *inter alia*, the members did not receive any consideration for the rights transferred. See *Robi v. Five Platters, Inc.*, 918 F.2d 1439, 1441 n.2 (9th Cir. 1990). However, a New York state court found that same agreement to be supported by valid consideration, since the group members had derived substantial benefit by their shares in and employment by the corporation. See *Robi v. Five Platters, Inc.*, 838 F.2d 318, 325 (3rd Cir. 1988).

In addition, a valid agreement may not be illegal or otherwise in violation of controlling statutory provisions. *Rare Earth, Inc. v. Hoorelbeke*, 401 F. Supp. 26 (S.D.N.Y. 1975) (contractual allocation of the group's name made in violation of state corporate law). Additionally, traditional contract law does not permit the enforcement of an agreement concerning the ownership of a group name when the result would in some way violate established principles of equity, such as laches or unclean hands. For a discussion of unclean hands, see *Fuqua v. Watson*, 107 U.S.P.Q. (BNA) 251 (1955). For a discussion of laches, see *Robi*, 918 F.2d at 1441 n.2. Furthermore, principles of voidability must also be considered. See *Bell v. Street-Wise Records, Ltd.*, 761 F.2d 67 (1st Cir. 1985) (underaged performers were entitled to avoid a recording agreement that they had entered into during their nonage).

258. Where a contractual allocation of a popular music group's name does not lead to a likelihood of confusion, traditional contract principles clearly govern. *Marshak v. Green*, 505 F. Supp. 1054, 1060-61 (S.D.N.Y. 1981). Cf. *E.F. Prichard Co. v. Consumers Brewing Co.*, 136 F.2d 512 (6th Cir. 1943) (holding that the license of a trademark gives the licensee no rights other than those specified in the contract), *cert. denied*, 321 U.S. 763 (1944); *California Packing Corp. v. Sun-Maid Raisin Growers*, 81 F.2d 674 (9th Cir.) (holding that the licensee of a trademark could not assign the trademark free of limitations in the original contract), *cert. denied*, 298 U.S. 668 (1936); *Peyrat v. L.N. Renault & Sons, Inc.*, 247 F. Supp. 1009 (S.D.N.Y. 1965) (holding that parties to a trademark controversy may contract between themselves for

for exchange should be permitted;²⁵⁹ however, under trademark law, once a finding of likely confusion has been made, that offensive use may be prohibited. To resolve the conundrum that is posed by these two conflicting sets of principles, the courts have engaged in a balancing process; the public benefit served by considering trademark principles is weighed against the policy of enforcing bargains struck in good faith.²⁶⁰

If an agreement has clearly been made for the purpose of avoiding or resolving public confusion, the balance should tip in favor of enforce-

any legal purpose, and such agreement is enforceable, as long as no injury is caused to the public).

A detailed contractual analysis of one such allocation was made in *Grondin v. Rosington*, 690 F. Supp. 200 (S.D.N.Y. 1988). Following the 1977 death of two of its members, the surviving members of Lynyrd Skynyrd orally and in writing agreed with each other never to use the band's name in connection with future activities. In 1987, however, the survivors decided to put together a tour that was booked as a "tribute" to Lynyrd Skynyrd. Ronnie Van Zant's widow reluctantly acquiesced to the tour; however, she later filed suit to enforce the non-use agreement, claiming that she never agreed to the use of the Lynyrd Skynyrd name for the new tour band.

At trial, the surviving members all conceded that they had entered into the so-called "blood-oath" concerning the future use of the band's name. *Id.* at 204. Nevertheless, the survivors claimed that Van Zant's widow was not entitled to enforce the agreement, since she had been neither a party to nor a beneficiary of the agreement. However, the court found that the surviving members had displayed an intent to benefit the memory and/or estate of Ronnie Van Zant, of which his widow was the personal representative. *Id.* Furthermore, the non-use agreement had purported to be a modification of an earlier shareholder agreement to which Van Zant had been a party. That agreement expressly inured to the benefit of the heirs and legal representatives of the parties. Thus, Van Zant's widow, as an intended third-party beneficiary, could enforce the agreement against the surviving members. *Id.* Despite the fact that it found the agreement to be enforceable against the surviving members, the court ultimately based its decision solely upon trademark law, which it viewed to be an "alternative" theory to contract enforcement. *Id.*

259. Of course, if the parties are not equal in bargaining position, any agreement struck between them may be unenforceable. *See Robi* 918 F.2d at 1441 n.2.

260. *Beer Nuts, Inc. v. King Nut Co.*, 477 F.2d 326, 329 (6th Cir.), *cert. denied*, 414 U.S. 858 (1973); *see also T & T Mfg. Co. v. A.T. Cross Co.*, 587 F.2d 533 (1st Cir. 1978), *cert. denied*, 441 U.S. 908 (1979) (court maintained that the degree or extent of public confusion must be examined in order to determine whether a trademark agreement should be enforced); *see also Larkin v. Polygram Records, Inc.*, No. 86 Civ. 1128 (RWS), 1986 WL 6174 (S.D.N.Y. 1991).

Note however, that a few courts have apparently refused to engage in such balancing. Some of these courts have looked solely to trademark law. *See Von Faber-Castell v. Faber*, 139 F. 257 (2d Cir.), *cert. denied*, 199 U.S. 609 (1905) (Wallace, J., concurring), where the concurring judge suggested that a non-use agreement concerning a trade name simply could not be enforceable in the face of allegations of unfair competition. *Id.* at 260.

At least one court has looked solely to contract law, despite an allegation of likely consumer confusion. In *Republic Pictures Corp. v. Rogers*, 213 F.2d 662 (9th Cir.), *cert. denied*, 348 U.S. 858 (1954), the court maintained that a party who had expressly consented to a proposed use could not later contend that the use would amount to unfair competition. Some courts have reached a similar conclusion on grounds of estoppel. *See Marshak v. Green*, 505 F. Supp. 1054 (S.D.N.Y. 1981); *The Four Aces Litigation: What's in a Name?* 5 ART & THE LAW 67 (1980).

ment and against a finding of infringement.²⁶¹ Many contractual agreements concerning the use or ownership of a popular music group's name contain "leaving member" provisions, which expressly permit the use of a "formerly of" label for a short period of time. These provisions are generally designed to serve dual purposes. First, they recognize the ex-member's contributions to the success of his former group by allowing him to take limited advantage of his former association. Second, they seek to inform the public about the ex-member's current estrangement from his former group. Thus, with the use of "formerly of" labels, the likelihood that the public will be confused about the future source of entertainment services and goods is significantly reduced. Hence, the balance between permitting the contractually-authorized use and prohibiting the potentially trademark-offensive use should generally tip in favor of contract enforcement.²⁶²

Where, however, an agreement is likely, even unwittingly, to increase the possibility of consumer confusion, the balance may tip away from enforcement and in favor of a finding of infringement. Agreements that amount to assignments in gross or transfers of personal marks tend to carry the greatest potential for increasing such confusion.

a. Assignments in Gross

The Lanham Act expressly permits a mark to be transferred with the goodwill of the business in which the mark has been used.²⁶³ Such transfers are permitted, since the mark remains attached to the goods or services that entitled the mark to protection in the first place.²⁶⁴ Because

261. See *E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973); *Beer Nuts, Inc.* 477 F.2d 326. The defendant in *Beer Nuts, Inc.*, had signed a non-use agreement concerning the name "Brew Nuts." When he was sued for breaching that agreement, the defendant claimed that the agreement should not be enforced because the mark in question was merely descriptive. The court disagreed, maintaining that "the public interest in guarding against the depletion of the general vocabulary available for the description of articles of commerce is not so great that it should take precedence over the rule of the law of contracts that a person should be held to his undertakings." *Id.* at 329.

262. See *Burrus Mill & Elevator Co. v. Wills*, 85 S.W.2d 851 (Tex. Civ. App. 1935), where the court maintained that the use of a "formerly of" label can help to avoid consumer confusion by publicly disassociating a former member from his group. This may be particularly true where the use of the label is limited to the first solo effort of a leaving group member.

See also *Kingsmen v. K-Tel Int'l, Ltd.*, 557 F. Supp. 178 (S.D.N.Y. 1983). That court believed that no public confusion would result from a label that read, Jack Ely, "formerly of the Kingsmen" or "Jack Ely, lead singer on the original Kingsmen recording of Louie, Louie." *Id.* at 183-84.

But see *Cesare v. Work*, 520 N.E.2d 586 (Ohio Ct. App. 1987), where the use of the phrase "formerly of Revolver" was found to have contributed to a likelihood of confusion.

263. 15 U.S.C. § 1060 (1988).

264. *Cf. Levitt Corp. v. Levitt*, 593 F.2d 463 (2d Cir. 1979) (court found that injunctive relief was appropriate to prevent the seller of a business and its "goodwill" from continuing to

the mark remains so attached, the public will not become confused as to the source of the goods.²⁶⁵ *Marshak v. Green*²⁶⁶ demonstrates the manner in which such a transfer may be successfully accomplished. In that case, three members of The Drifters assigned their rights under a trademark application to their manager. The assignment instrument clearly provided for the transfer of both the good will attached to the Drifters' entertainment business and the "Drifters" mark. Hence, the manager in essence acquired the right to hold himself out to the public as having not only the special experience and skill symbolized by the "Drifters" name but also the sole right to market the Drifters' services.²⁶⁷ The specter of consumer confusion was thereby avoided.

However, an attempt to transfer a mark without the accompanying good will, or a so-called "assignment in gross" of a mark, is not enforceable, since it is likely to increase the possibility of consumer confusion.²⁶⁸ A mark does not constitute an independent object of property; rather, it exists solely as a right appurtenant to an established business or trade.²⁶⁹ The interest in the mark is protected not because of any intrinsic merit in the mark but rather as a means of protecting the goodwill of the source that the mark symbolizes.²⁷⁰ When a mark is transferred without goodwill, a different business gains the benefit of the reputation of the business to which the mark had previously been attached.²⁷¹ Thus, when a mark is disassociated from the product to which it was initially attached, it loses the characteristics that originally gave it value.²⁷² Furthermore, such a transfer may well cause a dilution of the goodwill to which the mark was originally attached.²⁷³ Therefore, when a transfer in gross oc-

use his name, Levitt, and variations thereof, i.e. Levittown, to promote his own projects); RESTATEMENT (FIRST) OF TORTS § 755 cmt. b (1939).

265. RESTATEMENT (FIRST) OF TORTS, § 755 cmt. b (1939).

266. 505 F. Supp. 1054 (S.D.N.Y. 1981).

267. *Marshak*, 505 F. Supp. at 1061; see also *Levitt Corp.*, 593 F.2d 463.

268. Some courts have even held that an attempt at an assignment in gross results in a finding of abandonment of the mark. *E.F. Prichard Co. v. Consumers Brewing Co.*, 136 F.2d 512, 522 (6th Cir. 1943), cert. denied, 321 U.S. 763 (1944). However, other courts have expressly rejected this approach. See, e.g., *Li'l Red Barn, Inc. v. Red Barn Sys., Inc.*, 322 F. Supp. 98, 107 (N.D. Ind. 1970).

269. *Rockowitz Corset & Brassiere Corp. v. Madam X Co.*, 162 N.E. 76 (N.Y. 1928); see also RESTATEMENT (FIRST) OF TORTS § 755 cmt. b (1939).

270. RESTATEMENT (FIRST) OF TORTS § 755 cmt. b (1939).

271. *Ward-Chandler Bldg. Co. v. Caldwell*, 47 P.2d 758 (Cal. Ct. App. 1935); see also *Macmahan Pharmacal Co. v. Denver Chem. Mfg. Co.*, 113 F. 468 (8th Cir. 1901); *Mayer Fertilizer & Junk Co. v. Virginia-California Chem. Co.*, 35 App. 425 (D.C. 1910).

272. *Macmahan Pharmacal Co.*, 113 F. 468. See also *Ward-Chandler Bldg. Co.*, 47 P.2d 758, where the court explained the problem involved with transfers in gross by remarking that "the shadow cannot be separated from the substance." 47 P.2d at 760 (quoting *Children's Bootery v. Sutker*, 107 So. 345, 348 (Fla. 1926)).

273. See *Levitt Corp. v. Levitt*, 593 F.2d 463, 468 (2d Cir. 1979).

curs, the mark so transferred becomes a false designation²⁷⁴ and hence a fraud upon the public.²⁷⁵

*Albertini v. Giglio*²⁷⁶ demonstrates the problems that may arise when a transfer in gross is attempted. In that case, the remaining members of the post-World War II vocal group called "The Four Aces" entered into an agreement in 1958 with Al Alberts, an original member who had decided to resign from the group.²⁷⁷ Under this agreement, Alberts surrendered to the remaining members his rights to the group's name. In addition, Alberts agreed to their continuation of the group and promised not to compete with them. The group did continue to perform;²⁷⁸ however, one by one all of the original members left, ceding the right to the group name to those who remained with the group.²⁷⁹ When a fifties nostalgia wave hit at the start of the 1970s, the four original members of the group decided to perform again as The Four Aces.²⁸⁰ After approximately one year of competition, the original members sued the replacement members, claiming confusion in the minds of, *inter alia*, the public and booking agents.

The plaintiffs did not contest the initial validity of the agreement executed by Alberts; rather, they maintained that the defendants' right to use the name "The Four Aces" ended when Louis Silvestri, the last original member, left the group. Because "The Four Aces" functioned as a trade name for the group, the court held that it could only be assigned as an adjunct of the musical group to which it had been associated. However, the departing members had effectively "divorced" themselves from

274. *Id.* See also RESTATEMENT (FIRST) OF TORTS § 755 cmt. b (1939).

275. *Mayer Fertilizer & Junk Co.*, 35 App. 425.

276. See *The Four Aces Litigation: What's in a Name?* 5 ART & THE LAW 67 (1980).

277. Along with Alberts, whose real name was Albert Albertini, the original members of this group were Dave Mahoney, Rosario "Sod" Vaccaro, and Louis Silvestri. The group, which was formed in 1946, is best known for its rendition of "Three Coins in the Fountain." *Id.* at 67.

278. Ferdinand Diodati had been hired to replace Alberts. *Id.*

279. Mahoney and Vaccaro both left in 1969 and were replaced by Joseph Giglio and Anthony Alesi respectively. Silvestri eventually left in 1976—and rejoined forces with Alberts, Mahoney, and Vaccaro. Silvestri, Mahoney, and Vaccaro all failed to execute a written agreement upon leaving the group; however, they conceded that their successors had the right to continue to perform as the Four Aces. *Id.*

280. In preparation for their "revival," Silvestri (who at the time was still a member of the "replacement" group) filed a Lanham Act registration for the group's name and logo, claiming that the four original members, as a partnership, were the owners. This registration was subsequently found to be void. *Id.*

In addition, Silvestri, Mahoney, and Vaccaro all executed an instrument purporting to release Alberts from the restrictions imposed by his 1958 separation agreement. This release was also subsequently found to be void on the grounds that (1) the rights of Mahoney and Vaccaro terminated when they left the group and (2) Silvestri, acting alone, had no power to bind his new partners, the defendant group. *Id.* at 67-68.

the group and its attendant goodwill. Any subsequent attempts to transfer their rights in the group's name would only lead to further consumer confusion over the source of the entertainment services in question. Hence, such assignments could amount to no more than unenforceable transfers in gross.²⁸¹

b. Transfers of Personal Marks

In some instances, a mark may be deemed to be "personal," because it indicates to the public the personal skill and care that were exercised by a particular individual in providing the goods or services in question.²⁸² As a general rule, the unique nature of a personal mark renders it non-assignable.²⁸³ In *Messer v. "The Fadettes,"*²⁸⁴ the manager of a band of musicians sold to another individual all of her rights in the band's name. According to the court, any rights that the manager may have had in the name as a mark were personal to her, since those rights depended upon her personal reputation and skill.²⁸⁵ Furthermore, the use of the name by the assignee would mislead and defraud the public,

281. *Id.* For another allegation of a transfer in gross, see *Capetola v. Orlando*, 463 F. Supp. 498 (E.D. Pa. 1978). That case involved a series of transactions that left the court "a bit mystified." *Id.* The plaintiffs in that case were a young singer, Joan Capetola Robertson, and her parents, Arthur and Frances Capetola, who served as her managers. In 1967, the singer, who performed under the name "Dawn," transferred her rights in that name to her parents' management partnership. The partnership then licensed the right to use the name back to the singer.

In 1970, producer David Appel released a recording called "Candida." Although a music publishing executive named Tony Orlando and several backup singers had actually recorded the song, the release identified the artists as Dawn. When Frances Capetola objected to the use of that name, Appel offered to strike a deal with her. As a result of that deal, Appel signed Joan to serve as the "road or recording group for the Orlando releases." *Id.* at 501. Under this arrangement, Joan toured the country performing and promoting Orlando's "Candida" at record stores and shopping centers, autographing copies of the records, and otherwise promoting sales of the Orlando song. During this same time period, the agreement permitted Orlando to continue to record anonymously as Dawn.

By 1971, however, the success of "Candida" and three subsequent recordings convinced Orlando that he should no longer remain anonymous. He therefore purchased from Appel all the latter's right, title, and interest in the name "Dawn" and its accompanying goodwill. Following the execution of that transaction, Orlando began to perform in public as Dawn. Joan also continued to perform separately under that same name. After a series of traded warnings and rejected settlement offers, Joan and her parents sought injunctive relief against Orlando's future use of the name.

In the hearing upon his motion for summary judgment, Orlando argued, *inter alia*, that Joan's transfer to Appel amounted to a transfer in gross, which resulted in an abandonment of the mark by the Capetolas. 463 F. Supp. at 507. The court found material issues of fact to exist on this and other arguments raised; hence, the motion for summary judgment was denied. *Id.*

282. *Ward-Chandler Bldg. Co. v. Caldwell*, 47 P.2d 758 (1935).

283. *Id.*

284. 46 N.E. 407 (1897).

285. *Id.*

since such a use would imply the quality that the public had come to associate with the assignor. As a result, the court refused to enforce the assignment.²⁸⁶

A similar rationale underlies the holding in *Fuqua v. Watson*.²⁸⁷ The name "Ink Spots" had become known and associated in the eyes of both the general public and the entertainment world with the four original members of the group. The pecuniary value of the name thus derived from the personal skills of those four. And as a result, the name became an asset of the joint venture or partnership conducted by the four.

However, when Jones died, that business entity ceased to exist. The right to the name did not pass to the survivors to hold collectively because the name's value had been derived solely from the joint personal efforts of the now defunct original group. The name thus amounted to a non-assignable personal mark.²⁸⁸

Thus, where a contractual agreement concerning the use or ownership of a popular music group's name raises the issue of consumer confusion, the court must, in determining infringement, balance the principles of contract law against those of trademark law. Where such an agreement is designed to or has the effect of lessening consumer confusion, the balance should weigh in favor of contract enforcement, despite a finding of potential confusion. In such a case, a finding of infringement should not be made. Where, however, an agreement increases the possibility of consumer confusion, the balance should swing in favor of trademark prohibition. In such a case, a finding of infringement should be made.

B. Injunctive Relief

A wide variety of factors must thus be balanced in order to determine whether an infringement of a popular music group's mark has occurred. If a finding of infringement is made, the Lanham Act permits the court to award injunctive relief,²⁸⁹ both preliminary²⁹⁰ and permanent.²⁹¹ In determining the appropriateness of permanent injunctive relief, the court must balance the equities, taking into account the interests of the

286. *Id.* The dissenting opinion in this case agreed that a personal mark is not assignable. However, the dissent believed that a personal mark may become assignable if it is sold with the business. *Id.* at 407 (Lathrop, J., dissenting).

A personal mark may indeed become transferable if it has been used in a manner that has deprived it of its personal nature. *Ward-Chandler Bldg. Co.*, 47 P.2d at 758. If such a use occurs, the mark comes to indicate merely that the goods are of a standard quality, rendering the mark transferable with the goodwill of the business. *Id.*

287. 107 U.S.P.Q. (BNA) 251 (N.Y. Sup. Ct. 1955).

288. *Id.* at 252.

289. Section 34(a) provides that "[t]he several courts vested with jurisdiction of civil actions arising under this Act shall have power to grant injunctions, according to the principles

senior user, the junior user, and the public.²⁹² When properly designed, injunctive relief can, with one stroke, serve the goals of trademark law by rewarding a senior user who has diligently used the name in commerce, by punishing a junior user who has acted in bad faith, and by preventing future confusion in the consuming public.

A broad stroke that prohibits all future use by the defendant may thus be justified. In *Five Platters, Inc. v. Purdie*,²⁹³ the "peripatetic" nature of the two rival Platters groups caused the court to issue a perma-

of equity and upon such terms as the court may deem reasonable, to prevent" a violation under section 1125. 15 U.S.C. § 1116 (1988).

When a violation of section 43(a) has been shown, the plaintiff is also entitled to recover monetary relief, which may include both the profits earned by the defendant and the damages suffered by the plaintiff. 15 U.S.C. § 1117 (1988). See also *Stuart v. Collins*, 489 F. Supp. 827 (S.D.N.Y. 1980) (damages awarded to compensate the plaintiff for both the profits earned by the defendants and for the loss of goodwill that the plaintiff suffered). Treble damages may also be awarded where the infringement has been willful, malicious, or fraudulent. 15 U.S.C. § 1117(b) (1988); *Five Platters, Inc. v. Purdie*, 419 F. Supp. 372 (D. Md. 1976). Note, however, that an award of money damages may be denied if the plaintiff has been guilty of laches. *Three Degrees*, *supra* note 36.

290. In order to obtain preliminary injunctive relief under the Lanham Act, a plaintiff must show probable success on the merits and the likelihood of irreparable harm in the absence of such relief. *Kingsmen v. K-Tel Int'l, Ltd.*, 557 F. Supp. 178 (S.D.N.Y. 1983); *Estate of Presley v. Russen*, 513 F. Supp. 1339 (D.N.J. 1981). As with likelihood of confusion, actual confusion need not be proved for preliminary injunctive relief. *Kingsmen*, 557 F. Supp. at 181.

291. In order to make an award of permanent injunctive relief, the court must find a likelihood of future injury to the plaintiff and the inadequacy of legal relief to cure that future injury. *Five Platters, Inc.*, 419 F. Supp. at 372.

292. *Rick v. Buchansky*, 609 F. Supp. 1522, 1542 (S.D.N.Y.), *appeal dismissed*, 770 F.2d 157 (2d Cir. 1985).

The court must also be certain that the plaintiff is not guilty of unclean hands or laches. An allegation of unclean hands involves some imputation of wrong-doing on the part of the plaintiff. See *Rick*, 609 F. Supp. at 1541; *Fuqua v. Watson*, 107 U.S.P.Q. (BNA) 251 (N.Y. Sup. Ct. 1955). An allegation of laches requires proof of an inexcusable delay in taking action against a known use by the defendant. *Rick*, 609 F. Supp. at 1541.

See also *Stuart*, 489 F. Supp. at 827, where the court declined to award injunctive relief on the ground that the plaintiff would be adequately compensated by an award of money damages. The *Stuart* court further noted that the defendants, through their infringing use, had effectively appropriated the market for the plaintiff's name "Rubberband." As a result, the plaintiff could no longer hope to use his name in commerce. The issuance of an injunction would thus harm the defendants without benefitting the plaintiff. The court found this fact to be further evidence that injunctive relief was inappropriate. *Id.* at 835.

But see *Bell v. StreetWise Records, Ltd.*, 761 F.2d 67 (1st Cir. 1985). The concurrence in that court of appeals case took issue with the judgment previously entered by the district court, which had declined to order an injunction against either party. The concurring appellate judges cautioned that such a judgment, which left both parties free to use the name "New Edition," would undoubtedly lead to even further consumer confusion. *Bell*, 761 F.2d at 75-76. On remand, the district court ultimately awarded the plaintiff singers temporary injunctive relief against their former label and manager. 640 F. Supp. 575, 582 (D. Mass. 1986).

293. 419 F. Supp. at 384.

nent injunction that was nationwide in scope.²⁹⁴ Furthermore, the court not only enjoined all future performances by the defendants but also permitted the plaintiffs to destroy "all signs, pictures, advertisements, stationery, and paraphernalia in possession of the defendants which bear the word 'Platters' and any paraphernalia used to make them."²⁹⁵

However, broadly drawn injunctive relief may unduly burden an innocent junior user without rewarding the senior user or adequately protecting the public. Furthermore, injunctive relief can frustrate carefully-drawn agreements entered into in good faith by members of a musical group either among themselves or with their managers or labels. Broad

294. *Id.* The plaintiff group had performed across the country on television and in live appearances. The defendants had confined their performances primarily to the eastern half of the United States and Canada; however, the court did not trust them to refrain from competition in distant locations. *Id.*

In *Three Degrees*, *supra* note 36, the defendant Three Degrees Worldwide asked the court to clarify the extraterritorial applicability of the permanent injunction originally awarded in that case. 1989 WL 119697 (E.D. Pa. Oct. 12, 1989), *aff'd*, 902 F.2d 1562 (3d Cir. 1990). The court noted that the scope of trademark rights in another country is generally left to the determination of the courts of that country. 1990 WL 121506, at *1 (E.D. Pa. Aug. 17, 1990). However, in rare cases, injunctive relief may be extended beyond U.S. borders. *Id.* Such an extension requires a consideration of three factors: 1) whether the defendant is a U.S. citizen, 2) whether the extraterritorial activities of the defendant have a substantial impact upon commerce, and 3) whether an extraterritorial injunction will encroach upon foreign trademark law. *Id.* Because the plaintiff Three Degrees Enterprise had established a foreign presence in Monte Carlo, the court did extend the injunction's reach to that principality. *Id.* However, because the plaintiff had not established a presence in any other foreign venues, the court refused to give the injunction further extraterritorial effect. *Id.* at *2.

295. 419 F. Supp. at 384.

A similarly broad injunction was issued in two cases involving the use of the name "The Drifters." In *Marshak v. Green*, 505 F. Supp. 1054, 1061 (S.D.N.Y. 1981), the current manager of The Drifters sought injunctive relief against former members of the group who had been performing under "The Drifters" name. Upon a finding of infringement and likelihood of confusion, the court entered a decree "enjoining defendants from continuing to perform under the name 'The Drifters' or any variant thereof." *Id.* In addition, the decree prohibited the use of "The Drifters" mark on billboards or other promotional material and required the defendants to surrender to the plaintiff any promotional materials that bore "The Drifters" mark. *Id.*

In *Marshak v. Sheppard*, 666 F. Supp. 590 (S.D.N.Y. 1987), that same manager sought injunctive relief against yet another former member of the group who had been competing under the same name. The court found that the manager was entitled to the same injunctive relief against this former member as he had obtained against the other former members in *Green*. 666 F. Supp. at 604. Marshak also succeeded in obtaining broad injunctive relief against Bill Pinkney, yet another renegade former member of The Drifters. See *Marshak v. Bridge*, 902 F.2d 1565 (4th Cir. 1990) (unreported decision).

See also *Three Degrees*, *supra* note 36, (defendant Three Degrees group was permanently enjoined from any future infringing use and was given 30 days to remove any infringing materials from commerce); *Rick*, 609 F. Supp. at 1522 (defendants were enjoined from performing live or from recording under the name "Vito and the Salutations" and were prohibited from advertising and promoting services under that name); *HEC Enters., Ltd. v. Deep Purple, Inc.*, 213 U.S.P.Q. (BNA) 991 (C.D. Cal. 1980) (plaintiff Deep Purple group entitled to permanent injunctive relief against the defendant Deep Purple group for a wide variety of activities, including performing and advertising under the "Deep Purple" name).

relief may therefore not be the proper solution. Rather, the appropriate remedy may be injunctive relief that is narrowly tailored to fit the circumstances of the particular case.²⁹⁶

For example, the comparative interests of the junior and senior users may dictate permanent injunctive relief that is limited in geographic scope. In *Anderson v. Capitol Records, Inc.*,²⁹⁷ a San Francisco Bay Area group named "Flash" proved that Capitol Records had infringed upon the plaintiff's mark by selling in the Bay Area albums recorded by an English group also known as "Flash." The court enjoined Capitol from further marketing and distribution of that album; however, since the plaintiff's mark had achieved a secondary meaning only in the Bay Area, the injunction was limited solely to that location.²⁹⁸

Furthermore, circumstances may require injunctive relief to be tailored to avoid the infliction of additional confusion on the consuming public. In *Rick v. Buchansky*,²⁹⁹ the court found not only that the plaintiff group owned the mark "Vito and the Salutations" but also that the defendant group had infringed upon that mark by performing under that same name. The defendant group was therefore enjoined from future use of the group's name. Nevertheless, the court was concerned that future confusion might arise from the changing composition of the groups in

296. The First Restatement of Torts suggested that a court consider the following factors when determining the scope of injunctive relief: the manner in which the plaintiff has been harmed, the possible means by which that harm can be avoided, the justification advanced for the defendant's conduct, the inconvenience that would be caused to the defendant by each of several means of avoidance, and their effect on competition between the goods of the plaintiff and the defendant. RESTATEMENT (FIRST) OF TORTS § 744 cmt. c (1939).

297. 178 U.S.P.Q. (BNA) 238 (Cal. App. Dep't Super. Ct. 1973).

298. The court defined that area to include the following California counties: Santa Clara, San Mateo, San Francisco (city and county), Alameda, Contra Costa, and Marin. *Id.* at 242.

See also *Cesare v. Work*, 520 N.E.2d 586 (Ohio Ct. App. 1987). That court noted the disparate treatment that cases have afforded to the geographic scope of injunctive relief. *Id.* at 596. Where an infringement has been unknowing, the junior user may be permitted to perform in geographic areas previously untouched by the senior user. *Id.* However, where the junior knowingly adopted the senior user's mark, courts have not been so sympathetic. *Id.* Because the defendant group in this case had acted in bad faith in adopting the trade dress in question, the court issued a nationwide injunction. *Id.* at 597.

See also *Dolby v. Robertson*, 654 F. Supp. 815 (N.D. Cal. 1986). In that case, the court found that the "balance of equities" dictated narrow injunctive relief. *Id.* at 823. Under the relief granted, the defendant Thomas Dolby was permitted to continue to use that stage name on recordings and in his musical career. *Id.* However, he was enjoined from using the surname "Dolby" alone or to use the full name in a way that would call attention to the surname at the expense of the first (e.g., "Thomas DOLBY"), since that might result in consumer confusion with the noise reduction system marketed by the plaintiff Ray Dolby. *Id.* Furthermore, the defendant was entitled to produce music for films and to promote sound equipment, but he was not allowed to intimate responsibility for sound quality. *Id.*

299. *Rick v. Buchansky*, 609 F. Supp. 1522 (S.D.N.Y.), appeal dismissed, 770 F.2d 157 (2d Cir. 1985).

question, particularly since certain individuals had from time to time performed with both groups.³⁰⁰ The court therefore enjoined both parties from promoting or advertising in a manner that would misrepresent the identities of the members of their groups.³⁰¹ The injunction extended to "radio, television, and newspaper advertising, as well as oral or written representations made to media, restaurants, supper clubs, booking and theatrical agents;" however, the decree covered only those groups that included one or more individuals who had performed under the name "Vito and the Salutations."³⁰²

Several courts have recently suggested labelling as an alternative form of injunctive relief that can be used to respond narrowly but effectively to the exigencies of the individual case. In *Grondin v. Rossington*,³⁰³ the court recognized the confusion that was likely to result from the release of a 1987-88 Lynyrd Skynyrd tour album. To stem that confusion, Ronnie Van Zant's widow had asked the court for the broadest form of equitable relief, requiring MCA not only to recall all existing copies but also to submit to an accounting for profits already received.³⁰⁴

However, the court decided to limit the scope of relief so as to reduce the hardship to be suffered by the record producer, MCA. The decree did not require MCA to recall albums currently in the marketplace. In addition, MCA was permitted to use all album jackets already manufactured.³⁰⁵ MCA's sole requirement under this decree was to label all jackets in a manner that explicitly announced that the recording was made by the new band in 1987 and not by the original band.³⁰⁶

300. The court gave several examples of the potential future confusion that could arise. First, since neither group currently contained all four of the original members of the group, confusion would arise if either group billed itself as the original group that had recorded "Gloria" and "Unchained Melody." 609 F. Supp. at 1545. Second, confusion could arise if either group advertised with photographs depicting individuals not currently with the group. *Id.*

301. *Id.* at 1546.

302. *Id.*

303. 690 F. Supp. 200 (S.D.N.Y. 1988).

304. The widow also requested that the defendant musicians be prohibited from future use of the band's name. Zabick, Dennis, & Gorski, *U.S. District Court, MANHATTAN LAWYER*, May 24-30, 1988, at 22.

305. The court noted that the plaintiff had approved the release of a recording of the 1987 tour. Furthermore, MCA produced the jacket at great expense. *Grondin*, 690 F. Supp. at 210.

306. *Id.* at 210-11. The court left the exact wording of the label to the parties unless they could not agree. *Id.* at 211. The album was ultimately labelled with the following legend:

Entire album recorded live on 1987 tribute tour featuring Johnny Van Zant, Gary Rossington, Ed King, Randall Hall, Leon Wilkeson, Billy Powell, and Artimus Pyle and not including the following: Ronnie Van Zant, Allen Collins, and Steve Gaines.

The reconstituted Lynyrd Skynyrd recently released another compact disc, entitled "Lynyrd Skynyrd 1991." Apparently in keeping with the spirit of the decree entered by the *Grondin* court, the band labelled the new disc's jewel box with the following legends:

Labelling may thus offer an attractive compromise to a court faced with a request for injunctive relief, since labelling can be used to protect both the public and the senior user without unduly burdening the junior user. In *CBS, Inc. v. Springboard International Records*,³⁰⁷ the court was asked to issue preliminary injunctive relief against Springboard Records, which had released deceptively labelled albums containing old recordings by Charlie Rich and the group LaBelle. The court did not enjoin further release of the albums;³⁰⁸ rather, the court simply required Springboard to affix to the cover of the three offending albums a two by three inch bold-face label reading "These Songs Were Recorded Over Ten Years Ago."³⁰⁹

Furthermore, the harshness of injunctive relief may be softened through judicially permitted use of a "formerly of" label. In *Three Degrees Enterprise, Inc. v. Three Degrees Worldwide, Inc.*,³¹⁰ the defendant group, Three Degrees Worldwide, was permanently enjoined from performing under the name "Three Degrees"; however, the court's order expressly permitted the defendant's members to bill themselves as "formerly members of Three Degrees" and to perform under a new group name "featuring former members of Three Degrees."³¹¹

First studio recording of new music in over 13 years. Lynyrd Skynyrd 1991 is: Gary Rossington, Ed King, Leon Wilkeson, Billy Powell, Artimus Pyle, Randall Hall, Kurt Custer, and Johnny Van Zant.

The group has also toured in conjunction with the release of this album. See Anderson, Seymour & Fletcher, *New Releases*, *NEWSDAY*, July 7, 1991, Fanfare, at 17.

307. 429 F. Supp. 563 (S.D.N.Y. 1976).

308. In a 1975 case brought by Rich against RCA for the release of an album that was similarly mislabeled, the court did order preliminary relief enjoining RCA from further sales of the album in its then-current jacket. *Rich v. RCA Corp.*, 390 F. Supp. 530 (S.D.N.Y. 1975).

309. *CBS, Inc.*, 429 F. Supp. at 569. The same legend was required for all advertisements concerning the albums. *Id.*

In a 1974 case brought by Rich against Gusto Records concerning a similarly mislabeled album, the court also ordered preliminary injunctive relief in the form of a label clarifying the contents of the album. *CBS, Inc. v. Gusto Records, Inc.*, 403 F. Supp. 447 (M.D. Tenn. 1974).

310. See *Three Degrees*, *supra* note 36.

311. 1990 WL 121506, at *5. However, in any such billing, the defendant's members were required to feature the label no more prominently (visually or aurally) than the names of the individuals or the group. *Id.* The defendant's members were additionally given the right to petition the court to deviate from these requirements after first attempting in good faith to secure permission from the plaintiff Three Degrees Enterprise. *Id.*

III

Suggested Criteria for Use in Resolving Trademark Litigation Concerning the Ownership or Use of the Names of Popular Music Groups

Despite the fact that the courts have been somewhat reluctant to tackle the task before them, they have struggled to resolve the difficult issues that surround the ownership and infringement of the names of popular music groups. As the discussion above indicates, these struggles have begun to produce identifiable criteria that can not only serve to prevent consumer confusion but can also help to preserve bargained-for exchanges. The immense value that now attaches to group names only reinforces the importance of adherence to the following criteria.

A. Criteria for Establishing Ownership of a Popular Music Group's Name

In many instances, ownership of a popular music group's name ought to be vested in the group as an entity.³¹² Such an allocation recognizes the group members' joint efforts in achieving success. In addition, such an arrangement permits the individual members of the group, acting through their interests in the group's business entity, to control the use of the valuable name that they have made. Furthermore, group ownership can help to prevent the public confusion that may arise if a manager or a label is awarded ownership and is thereby permitted to attach the name to someone or some entity that has no connection to the group that made the name.

1. *Establishing Ownership in the Absence of a Contractual Allocation*

Even in the absence of a contractual allocation, ownership should be awarded to the group if it satisfies the following criteria. First, ownership should be recognized in the group if it is the first to use the name in commerce in connection with all goods and services provided by the group. Proof that the group was the first to attach its name to recordings, live performances, and even commercial tie-ins can be used to establish not only priority in use but also secondary meaning, both of which are essential in establishing ownership under the Lanham Act.³¹³

312. Indeed, in *Bell v. StreetWise Records, Ltd.*, 640 F. Supp. 575 (D. Mass. 1986), the court went so far as to find that "the norm in the music industry is that an artist or group generally owns its own name." *Id.* at 581.

313. Proof of continuous use may also help to rebut a defense of abandonment. Evidence that the group continued to use its name in commerce, even after it has ceased to perform in public or has completely disbanded, can be particularly persuasive here. Such continued use

Second, if the group can establish that it retained control over its product, ownership should be given to the group, as an entity, rather than to individual members, a manager, or a label. Such control can be proved by evidence that, at every opportunity, the group claimed and asserted a noticeable measure of artistic control over its recordings and live performances. Further proof may be shown by the fact that the group retained a right of approval over all uses of the group's name.

As a corollary, an individual member of the group should prevail over the group in the rare case where he can prove that he by himself was primarily responsible for the group's success or if he has achieved such individual fame that the name or its secondary meaning has become associated with him rather than with the group. Likewise, a manager or a label should prevail only if it has exercised such control over the group that it is primarily responsible for the group's success.

2. Establishing Ownership in the Event of a Contractual Allocation

Courts should be particularly sensitive to the use of a carefully drawn contractual allocation of the group's name, which is often integrated with leaving member provisions. In many instances, such a contractual allocation vests ownership of the name in the group as an entity³¹⁴ and provides for continued group ownership, even in the face of the departure of one or all of the original members of the group. Where such an allocation in no way raises the question of consumer confusion, the court should enforce the agreement as written.³¹⁵

B. Criteria for Determining Whether a Popular Music Group's Mark Has Been Infringed

Courts are well aware that a finding of likelihood of confusion requires a balancing of a number of factors. However, in cases involving infringement of a popular music group's name, not all courts have been sufficiently careful in examining the traditional factors. In particular, courts need to pay more attention to the nature of the product and sophistication of consumers of popular music. Popular music runs a wide gamut, which includes such disparate music forms as heavy metal, rap, and disco. Furthermore, popular music fans encompass not only adoles-

can easily be found in the collection of royalties and other payments on past releases and commercial tie-ins.

314. A group may be tempted to assign its name in exchange for an attractive management or recording contract. Such assignments should be discouraged, however, since they inevitably leave the group powerless over the use of its most valuable asset, its name.

315. In some instances, a contract may allocate ownership to the group's manager or label. Before enforcement of such an allocation is ordered, the court should closely scrutinize the agreement for evidence of unfair bargaining power and other violations of public policy.

cents on allowances but also baby boomers with large disposable incomes. Whatever their level of education and wealth, however, these fans generally make knowledgeable purchases of music items. A court should therefore not be so quick to assume that all popular music "sounds alike" or that popular music consumers exercise no care in their musical purchases. Courts must therefore attribute an appropriate level of sophistication to both popular music and its consumers in order to achieve a proper balance when determining likelihood of confusion and resultant infringement.³¹⁶

In balancing the factors that contribute to a finding of likelihood of confusion, the court should also lend a more careful ear to contractual allocations concerning the group's name. Where such an allocation does not give rise to even the hint of consumer confusion, or where it is actually designed to avoid such confusion, the agreement should be enforced under traditional contract principles. A court should be particularly cognizant of this principle when it is called upon to judge a contractually-authorized use of a "formerly of" label, since the clear intent behind such a label is to provide the consuming public with a clearly-identified source of goods or services.³¹⁷

Where, however, a contractually authorized use may actually increase the likelihood of consumer confusion, in determining infringement, courts should carefully balance the policy of enforcing agreements against the policy of protecting the consuming public from confusion. The balance should tip away from enforcement if a mark is truly personal to one or more group members or if the group has indeed transferred the name without its attendant goodwill. However, courts should be wary of adhering too closely to the holdings of cases such as *Albertini v. Giglio* and *Fuqua v. Watson*.³¹⁸ a literal reading of those cases can effectively prevent groups from playing through inevitable changes in membership, even where the group has carefully planned for such future changes and even where the public is willing to accept the changes. In such cases, the potential loss caused by possible consumer confusion is

316. Such sophistication should also be considered as the court shapes its injunctive relief order.

317. Courts should also be attuned to the potential confusion that can be avoided through contractually-authorized "break-out" labels. A good example of the successful use of such a label can be found in the case of the Supremes. When Diana Ross decided to go out on her own, the group and its record company agreed to temporarily bill the group as Diana Ross and the Supremes. This label was designed to allow the public to begin to think of Ross as a solo artist. The label achieved its purpose, thus allowing the remaining members of the trio to continue to perform under the group's name, even after Ross' departure. S. SHEMEL & M. KRASILOVSKY, *supra* note 154.

318. 107 U.S.P.Q. (BNA) 251 (N.Y. Sup. Ct. 1955).

surely far less than the damage done to the honest and fair business agreements of the parties.

C. Criteria for Carefully Tailoring Injunctive Relief

A finding of likely consumer confusion and resultant infringement does entitle the owner of a popular music group's name to injunctive relief. However, the court should be wary of issuing unnecessarily broad orders. Rather, the court should be circumspect in the relief that it orders. For example, an injunction may be restricted to geographic area, particularly where the groups are local only in reach.³¹⁹ Injunctive relief may also be limited to a type of service or good (e.g., recordings only), particularly where the audience possesses a level of sophistication sufficient to permit it to easily recognize the source of the parties' other services and goods.

Furthermore, the court should be particularly open to the use of explanatory labelling as an alternative to total prohibition. Recording packages that conspicuously list the band's present members have recently been used to help groups such as Lynyrd Skynyrd and Van Halen³²⁰ successfully negotiate changes in membership. In addition, instead of completely prohibiting ex-group members from using their former group's name, the court should consider a judicially-authorized use of a "formerly of" label, at least for a limited time period.

Finally, the court should even be willing to forego injunctive relief if an injunction would cause undue harm to the defendant without providing adequate relief to the plaintiff.³²¹ By carefully tailoring the relief it grants to the circumstances before it, the court can thus prevent continued consumer confusion without unduly burdening either party before it.

Courts may well be unable to achieve "perfect" justice in every case involving trademark ownership or infringement of popular group names.

319. In the rare event that two groups are competing only with regard to certain products (e.g., live performances only), injunctive relief should likewise be limited to those types of services or goods.

320. Van Halen was formed in 1974 and featured Eddie and Alex Van Halen, Michael Anthony, and David Lee Roth. Roth left the band in 1985 and was replaced by Sammy Hagar. *Pop Eye*, L.A. TIMES, Aug. 18, 1985, Calendar, at 84. See also HARMONY, *supra* note 3, at 181. This band's hits include "Panama" and "Jump" (with Roth), "Why Can't This Be Love?" and "Love Walks In" (with Hagar).

Van Halen has traditionally listed current band members in large type on all album and compact disc covers (such a label was, however, missing from the band's most recent album, the 1991 "For Unlawful Carnal Knowledge"). In addition, great publicity accompanied the change in membership. See, e.g., *Pop Eye*, L.A. TIMES, Aug. 18, 1985, Calendar, at 84. The transition from Roth to Hagar was thus made with a minimum of confusion.

321. See, e.g., *Stuart v. Collins*, 489 F. Supp. 827, 835 (S.D.N.Y. 1980). Monetary relief, may, of course, still be available even if a request for injunctive relief is denied.

Neither the specter of an occasional impossible case nor a nagging unease with popular forms of music should be allowed to deter the courts from the task at hand. By following the criteria set forth above, courts can take a large step towards eliminating the uncertainties and doubts that currently devalue the incredible economic opportunities deriving from the ownership of a popular music group's name.